SUPREME COURT, U. S.

Office-Supreme Court, U.S.
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JAN 17 1966
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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1965

No. 915

W. E. GRACE MANUFACTURING COMPANY and
WILLIAM E. GRACE,
Petitioners

vs.

BROS INCORPORATED,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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IN THE

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No. .....

W. E. GRACE MANUFACTURING COMPANY and
WILLIAM E. GRACE,
Petitioners

vs.

BROS INCORPORATED,
Respondent.

PETITION FOR WRIT OF CERTIORARI

Petitioners, W. E. Grace Manufacturing Company and William E. Grace, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit in the above-entitled case. This judgment reversed a judgment of patent invalidity by the United States District Court for the Northern District of Texas.

REPORTS OF OPINIONS BELOW

The opinion of the Court of Appeals is reported at 351 F.2d 208, and is appended (App. 1a). The opinion of the District Court is reported at 227 F.Supp. 759, and is con-

tained in the single-volume record as printed for the use of the Court of Appeals, nine copies of which have been filed with this petition (R. 388; related Findings and Conclusions appear at R. 383).

GROUNDS FOR INVOKING JURISDICTION OF THIS COURT

The judgment of the Court of Appeals which this petition seeks to have reviewed is dated and was entered September 14, 1965 (App. 18a).

A timely petition for rehearing was denied by an order of the Court of Appeals entered October 20, 1965 (App. 19a), and an order staying execution of judgment was entered December 9, 1965, conditioned upon filing of this petition on or before January 18, 1966, and compliance with specified supersedeas requirements (App. 20a). No extension of time has been granted or requested.

Jurisdiction is believed to be conferred on this Court to review the judgment in question by writ of certiorari pursuant to 28 U.S.C. § 1254(1).

The jurisdiction of this Court is invoked on the ground that the Court of Appeals judgment in question has decided "a vital point of substantive patent law" in acknowledged conflict (App. 1a, 3a) with the decision of another court of appeals on exactly the same matter; i.e., the decision in *Bros Inc.* v. *Browning Mfg. Co.*, 317 F.2d 413 (8th Cir. 1963), certiorari denied, 375 U.S. 825 (App. 50a), in which the respondent here (Bros Inc.) was the unsuccessful petitioner and is currently requesting leave to file a petition for rehearing, so as presumably to be ready for agreement that the present petition should be granted.

The questioned judgment of the Court of Appeals below is also believed to involve implicit conflict with the decision of the Court of Customs and Patent Appeals currently pending on petition in *Application of Foster*, No. 347, October Term, 1965; and the circumstances of the case decided below are believed additionally to present a collateral question significantly akin to the issue just passed on by this Court in *Walker Process Equipment, Inc.* v. *Food Machinery & Chemical Corp.*, No. 13, this Term, decided December 6, 1965.

QUESTIONS PRESENTED

The question directly presented is this:

1. Where a printed publication is asserted to render a patent claim invalid by reason of the loss of right (or so-called "time-bar") provisions of Section 102 (b) of the Patent Act, must every limitation of the patent claim be viewed, *ipso facto*, as critically material in determining whether the printed publication describes the invention defined by the claim; that is, must there be a precise identity between the publication and the patent claim for "time-bar" purposes.

The additional question involved collaterally is:

2. Where a patentee's affidavit categorically denied a reasonably apparent time of printed publication, and the denial was affirmatively and effectively employed by the patentee to block an adjudged infringer's request for consideration of a newly discovered, printed publication "time-bar", should the infringer be allowed to counterclaim for damages upon establishing that the affidavit was untrue.

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

In pertinent part, the constitutional and statutory provisions involved are verbatim:

U.S. Const., Art. I, § 8. "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; . . . ."

35 U.S.C. § 101. "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

35 U.S.C. § 102. "A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * *."

35 U.S.C. § 103. "A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented

and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . . ."

STATEMENT OF THE CASE

Original jurisdiction in the District Court below arose under 28 U.S.C. § 1338 (a), the action brought there by respondent being one for patent infringement.

The respondent's patent sued upon was No. 2,610,557 (R. 425) covering a rubber-tired roller for compacting the earth fill of highway subgrades and comparable civil structure foundations. The patented roller is characterized by a large hollow body suited for ballast loading to place compacting weight on a set of four wheels, these wheels being aligned sidewise within an arched recess midway of the body bottom and articulated in pairs for oscillation about "fore-and-aft" axes, so as to be capable of following an uneven surface contour while carrying the body as if it were a two-wheeled cart.

The validity of this patent had been sustained in an earlier Ohio action brought by respondent against one of petitioners' dealers. *Gibson-Stewart Co.* v. *William Bros Boiler & Mfg. Co.*, 264 F.2d 776 (6th Cir. 1959), certiorari denied, 360 U.S. 929. Before the Ohio result had been affirmed on appeal, respondent instituted the present Texas action against petitioners in the District Court below and was successful in obtaining summary judgment on "principles of res judicata." *Bros Inc.* v. *W. E. Grace Mfg. Co.*, 261 F.2d 428 (5th Cir. 1958).

By the time an accounting report had reached the District Court in the Texas action, however, the respond-

ent's patent had been held invalid, in a Minnesota action against others, by reason of a newly discovered, printed publication "time-bar." *Bros Inc.* v. *Browning Mfg. Co.*, 317 F.2d 413 (8th Cir. 1963), certiorari denied, 375 U.S. 825 (App. 50a). The printed publication (R. 401) had initially been discovered just before the return of mandate by the Sixth Circuit in the Ohio action and, as it was respondent's publication, petitioners applied at once through their Ohio dealer-defendant for a Sixth Circuit reopening which was denied (App. 46a, 47a, 48a, and 49a). The Texas District Court also refused at the time to consider the newly discovered printed publication, but as the substance of the printed publication "time-bar" had now been confirmed by the Minnesota result, petitioners filed a timely renewal of the application for reopening of the Texas action following determination of the accounting issue by the District Court below.

This further reopening request was initially denied because the District Court felt it could not be considered without permission from the Fifth Circuit. The matter then went up on petitioners' cross-appeal accompanying a main appeal by respondent on the accounting issue, and the result was a Fifth Circuit authorization to hear the apparent justification for reopening. *Bros Inc.* v. *W. E. Grace Mfg. Co.*, 320 F.2d 594 (5th Cir. 1963). The portion of the Fifth Circuit decision dealing with the reopening authorization is appended (App. 22a) because it details quite fully the relevant circumstances including, in particular, those attending the previous reopening denial in the Sixth Circuit.

A significant aspect of the reopening application papers considered by the Sixth Circuit, as detailed by the Fifth Circuit (App. 22a, 26a), was an affidavit of the respondent-patentee (see R. 455 and R. 457) swearing that

it "did not cause" the printed publication in question (R. 401) "to be prepared and publicly distributed" (R. 457, 459) at a particular trade show which had occurred early enough to present a "time-bar" question, and which otherwise would have seemed virtually certain to have marked the time of publication. This affidavit additionally represented that the printed publication in question (R. 401) "was not prepared or distributed" by respondent "until long after" the trade show specified (R. 457, 459-60).

When the point was reached in the Minnesota action, the conclusion was that:

> "The entire record impels a finding that the pamphlet was distributed to a substantial number of people during the show in July, 1948, which was over a year prior to the application for the patent herein." (App. 58a, 64a).

On appeal in the Eighth Circuit, respondent did not challenge this time of publication finding (App. 50a, 52a), but it remained a point of contention in the Texas action upon return of the Fifth Circuit reopening mandate to the District Court below (see R. 379). That being so, petitioners obtained permission for further deposition examination of respondent's affiant in preparation for hearing of the reopening issue by the District Court. Just before this deposition examination was scheduled to commence, respondent disclosed (R. 417-418) that it had finally traced the time of publication through its records and found that it agreed with the time petitioners had been contending for all along (R. 417-418). When the deposition examination was conducted, however, it appeared (R. 98-108): that the time of publication had now been traced from the same accounting records which respondent had originally represented to reveal no clue; and that the printer was now found to be a Minneapolis company (Gile Letter Service) whose

name had been omitted from a further affidavit response (R. 463) to an order (R. 461) requiring respondent to disclose its printing sources for discovery purposes, whereas respondent admittedly knew at the time that this company had done printing work for it (R. 160-170).

When the matter was heard by the District Court below, the requested reopening was found to be fully justified because "actions chargeable" to respondent had "thwarted full disclosure of the facts" and amounted to "an abuse of the spirit of the Federal Rules" (R. 388, 397). Also, after a full hearing concerning the description of respondent's patented roller compactor by its printed publication (R. 401), the District Court held respondent's patent (R. 425) invalid by reason of the now established printed publication "time-bar" under Section 102 (b) of the Patent Act (R. 388, 397-400).

Finally, the District Court refused to consider any claim by petitioners for damages by reason of the injunction with which they had been burdened since 1959 through respondent's obstruction of the printed publication issue (R. 346-352).

When respondent appealed (R. 407) from the final judgment entered by the District Court (R. 405-407), petitioners filed a cross-appeal (R. 412-413) requesting review of the District Court's refusal to consider petitioners' claim for damages and seeking authorization for filing a counterclaim in a form appended to the cross-appeal brief for approval. This proposed counterclaim is also appended here (App. 71a) because it alleges the relevant circumstances in the connected manner that is believed to warrant consideration of petitioners' damage claim.

The decision of the Court of Appeals below (App. 1a) has four aspects that are believed to warrant noting.

First, the decision finds the reopening allowed petitioners to have been justified by the circumstances and affirms in that respect, although indicating a conclusion that the District Court had viewed respondent's discredited affidavit activity too severely (App. 1a, 4a-6a).

Secondly, the decision reverses as to the substantive legal effect of respondent's printed publication (R. 401), holding that it was "clearly erroneous" for the District Court to find respondent's patent (R. 425) invalid by reason of respondent's prior printed publication (R. 401) both because, as the Court of Appeals saw the record, the publication was not considered to disclose "the invention described by the claims," and because the "fact finding" by the District Court in this respect was not thought to have been "made in the light of the correct controlling legal principles" (App. 1a, 6a-17a). It is this aspect of the decision below that is in plain and acknowledged conflict with the Eighth Circuit decision in *Bros Inc.* v. *Browning Mfg. Co., supra* (317 F.2d 413; App. 50a).

A third notable aspect of the decision below is its concluding reservation of judgment with respect to respondent's argument "that the significance of the prior publication under § 102 (b) is something quite different from its use as prior art under § 103" (App. 1a, 18a). This argument was considered and rejected by the Eighth Circuit (App. 50a, 55a-57a); it forms the particular issue that is presented by the pending petition in *Application of Foster,* No. 347, October Term, 1965; and, as this petition will attempt to show presently, it does not appear possible for the decision below to have judged the printed publication "time-bar" properly without reaching this argument and ruling on it.

Fourth and last, it remains to notice that the decision below disposed of petitioners' cross-appeal "automatically" by final footnote treatment (App. 1a, 17a).

ARGUMENT

It is submitted that the Fifth Circuit decision below (App. 1a) favors another "area" in which patents may be "awarded for unpatentable advances in the art," in pointed conflict with the result in the Eighth Circuit on exactly the same facts, and that the compelling reason for resolving this conflict is much the same as was present in *Hazeltine Research, Inc.* v. *Brenner,* No. 57, this Term, decided December 8, 1965.

The printed publication "time-bar" provisions of Section 102 (b) of the Patent Act, which are involved here, work a "loss of right to patent" for any invention that has been "described in a printed publication" more than one year before the inventor applies for a patent. Thus, the matter to be judged in considering a printed publication "time-bar" is essentially that of deciding whether the publication so describes the subject matter of the subsequent patent application as to render allowance of the latter anomalous in view of the previously published teaching of the former.

When the printed publication issue of the present case was considered by the Eighth Circuit, the Minnesota District Court had found, despite respondent's denial, that the printed publication at issue (R. 401) had been distributed by respondent early enough to constitute a "time-bar" (App. 58a, 64a). The Minnesota District Court had also noted it to be of "some significance" that during the Patent Office proceedings respondent had referred to this same printed publication (R. 401) "as a catalog disclosure of the invention" (App. 58a, 66a). And then, in the face of extended reargument of the claim details by respondent, the Minnesota District Court had carefully re-

worked its critical finding to the following form (App. 68a, 69a):

> "The published pamphlet . . . taught to the industry the essential elements and features of the patent in suit and the impelling weight of the evidence supports the finding, and the Court does find, that the essence of the invention, that is, the inventive concept which is the basis for the claims of this patent, was fully disclosed in this pamphlet and enabled one skilled in the art to build and produce the roller compactor described in this patent."

The Eighth Circuit held this finding to be "clearly one of fact" for determination by the District Court, and to be conclusive if supported by "a substantial evidentiary basis," because the test applied by the District Court in determining adequacy of the printed publication description was correct as a matter of law (App. 50a, 55a).

A comparable determination of fact was made by the Texas District Court below when it considered the printed publication issue on mandate from the Fifth Circuit (R. 388, 399). But, on the following appeal from the consequent judgment of invalidity (R. 405), the Fifth Circuit made a shibboleth of the patent claims (App. 1a, 9a-17a), and very literally so (see, in particular, App. 15a, footnote 25), as a basis for substituting its judgment of the record and reversing to restore the validity of respondent's patent in conflict with the Eighth Circuit.

It is submitted that to treat patent claims for Section 102 (b) "time-bar" purposes as the Fifth Circuit has done, is to grant claim language a mystical significance that has no warrant. The germ of error, and resulting lack of warrant, in the Fifth Circuit approach is believed to reside in a starting premise that is derived from authorities

where it is apt but is then applied to circumstances where it is not.

The starting premise is a familiar touchstone of patent law: "that it is the claim of a patent that measures the invention" (App. 1a, 9a). This proposition is serviceable enough where it is simply the reach of patent claims for infringement purposes that is being considered, as it was in the authorities that the Fifth Circuit cites (App. 9a, footnote 10), but the proposition will not generalize for "time-bar" purposes as the Fifth Circuit makes it seem.

The Fifth Circuit generalization does not follow because the coin has an opposite face; namely, that when claim limitations are accepted or imposed, either rightly or wrongly, they amount to disclaimers of what the limitations exclude. *Smith* v. *Magic City Club*, 282 U.S. 784. Actually, therefore, it is not the invention, as a generality, but the patent grant that is measured by the claim. *Milcor Steel Co.* v. *George A. Fuller Co.*, 316 U.S. 143. And the invention and the grant are not necessarily the same, for courts continually face the inherent difficulty of matching patent claims fairly with the inventive substance that otherwise appears from the patent disclosure and the surrounding circumstances. See *Smith* v. *Snow*, 294 U.S. 1; and *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211.

For "time-bar" purposes, it has always been the inventive substance and not the claim that governs. *Hall* v. *Macneale*, 107 U.S. 90; *International Tooth Crown Co.* v. *Gaylord*, 140 U.S. 55. Hall and International Tooth both dealt with a "time-bar" by reason of prior use, rather than printed publication, but the principle is the same, and both found that the inventive substance had been

in prior use so as to raise a "time-bar" against the claims in question despite claim limitations that differed in detail from the prior uses. The point is this: when the inventive substance has been abandoned by prior use or printed publication, any differing detail of claim limitation is stripped of significance by the skill of the art.

Just as it was a prior use by the patentee that was dealt with in each of Hall and International Tooth, so it is a printed publication (R. 401) of the respondent-patentee that is at issue here. And, furthermore, it is conceded here (R. 457-459) that respondent's printed publication (R. 401) illustrated the very machine that was subsequently disclosed and claimed by respondent's patent (R. 425). If there are claim limitation details in respondent's patent (R. 425) that its printed publication (R. 401) does not detail as fully, the Eighth Circuit has said that these limitations are of no consequence because the Minnesota District Court had found the printed publication to teach the inventive substance. The Texas District Court below made the same finding, but the Fifth Circuit has reversed on the ground that the claim limitation details must, as a matter of law, be taken to define the inventive substance.

If the Fifth Circuit view should prevail, the way would be clear to Section 102 (b) "time-bar" avoidance simply through strategic use of innocuous claim limitation. It is submitted that the conflict between the Fifth and Eighth Circuits in this respect should not be allowed to stand.

And if the Court agrees that the present petition should be granted to resolve this conflict, it is additionally submitted that the Court should consider and rule on the collateral issue involving petitioners' right to counter-

claim for damages. The basis for the counterclaim is generally stated at *Restatement, Torts,* § 873:

> "A person who, with knowledge of its falsity, makes an untrue statement concerning another which he realizes will harm the other is liable to the other for such resulting harm as he should have realized might be caused by his statement."

Circumstances not unlike respondent's discredited affidavit activity here led this Court to authorize a delayed counterclaim for damages by an adjudged infringer in *Shawkee Mfg. Co.* v. *Hartford-Empire Co.*, 322 U.S. 271; and the Court has recently treated a particular aspect of essentially the same matter in *Walker Process Equipment, Inc.* v. *Food Machinery & Chemical Corp.*, No. 13, this Term, decided December 13, 1965.

It is submitted that the circumstances at hand here not only present the elements of actionable fraud in general, but show an abuse of process as well, and amply warrant the Court's attention in passing on the case as a whole.

CONCLUSION

Wherefore, petitioners earnestly urge the Court to grant this petition.

Respectfully,

CHANNING L. RICHARDS
Attorney for Petitioners

CERTIFICATE OF SERVICE

Four copies of the foregoing petition for writ of certiorari have been served on respondent by depositing the same in the United States mails, with first-class postage prepaid, addressed to respondent's attorney, Andrew E. Carlsen, Esq., at 1128 Plymouth Building, Minneapolis, Minnesota, this 14th day of January, 1966.

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APPENDIX

APPENDIX

IN THE

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 21470

BROS INCORPORATED,
Appellant-Appellee,

VERSUS

W. E. GRACE MANUFACTURING COMPANY and
WILLIAM E. GRACE,
Appellees-Appellants.

(AND REVERSE TITLE.)

Appeals from the United States District Court for the Northern District of Texas.

(September 14, 1965.)

Before TUTTLE, Chief Judge, and BROWN and GEWIN, Circuit Judges.

BROWN, Circuit Judge: Now rounding out its first decade in this Court, this case, coming to us for the fourth

time with two intervening trips to the 6th Circuit and one to the 8th[1] is a tribute to "the ant-like persistence of [patent] solicitors," *Lyon* v. *Boh,* S.D.N.Y. 1924, 1 F.2d 48, 50, and their courtroom advocate counterparts as so much grist is made out of one patent.[2]

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1. This is the run-down from 6th to 5th to 8th and back again:

[1] D.C. Ohio, 1957:	William Bros Boiler & Mfg. Co. v. Gibson-Stewart Co., Inc., 116 USPQ 138
[2] D.C. Tex., 1958:	Bros Inc. v. W. E. Grace Mfg. Co., 158 F. Supp. 786
[3] 5 Cir., 1958:	Bros Inc. v. W. E. Grace Mfg. Co., 261 F.2d 428
[4] 6 Cir., 1959:	Gibson-Stewart Co., Inc. v. William Bros Boiler & Mfg. Co., 264 F.2d 776, cert. denied, 360 U.S. 929, 79 S. Ct. 1448, 3 L. Ed. 2d 1544
[5] D.C. Ohio, 1961:	William Bros Boiler & Mfg. Co. v. Gibson-Stewart Co., Inc., 202 F. Supp. 6, 132 USPQ 268
[6] D.C. Minn., 1962:	Browning Mfg. Co. et al. v. Bros Inc., 134 USPQ 231
[7] 6 Cir., 1963:	William Bros Boiler & Mfg. Co. v. Gibson-Stewart Co., Inc., 312 F.2d 385
[8] 8 Cir., 1963:	Bros Inc. v. Browning Mfg. Co., 317 F.2d 413, cert. denied, 375 U.S. 825, 84 S. Ct. 67, 11 L. Ed. 2d 58
[9] 5 Cir., 1963:	Bros Inc. v. W. E. Grace Mfg. Co., et al., 320 F.2d 594
[10] 5 Cir., 1964:	Bros Inc. v. T. Whitfield Davidson, 330 F.2d 65

To facilitate discussion, reference will be made to these decisions and page citations as follows: e.g., (Op. [3] 429) indicates 261 F.2d 428 at 429.

Having now occupied the attention of not less than 25 Judges in the Fifth, Sixth, and Eighth Circuits, this case brings sharply to mind the Chief Justice's May, 1965, address to the American Law Institute imploring the bench, the bar, and the public, to exert resourceful ingenuity in finding ways to maintain the quality of our celebrated system of justice without squandering precious and limited judge-time, on the one hand, or numerically expanding the structure to the point where it breaks down of its own weight as the nation explodes toward the 300-400 million mark. Perhaps the President's Commission On The Patent System under the chairmanship of Chancellor Ransom will think this problem worthy of its attention (Ex. Order No. 11215, 30 F.Reg. 4661 (1965)).

2. No. 2,610,557, application filed November 17, 1949, issued September 16, 1952, for pneumatic roller compactor.

Hopefully, this visit will achieve an end to this case, in this Court at least, although we fear that our decision is a prologue to another act since on a vital point of substantive patent law, we find ourselves in disagreement[3] with our distinguished Brothers of the Eighth Circuit.[4]

The stage for this scene may be quickly set. In our 1963 decision (Op. [9] we modified and affirmed infringement damages but remanded the case for determination of F.R.Civ.P. 60(b) relief based on an asserted § 102(b) prior publication of the Road Show pamphlet-brochure allegedly describing the patented earth compactor. The District Court on the remand found 60(b) relief warranted thereby releasing Fifth Circuit Courts from the binding res judicata effect of the Ohio judgments (Op. [1], [4], [5] and [7]). On the merits, it held, as did the 8th Circuit (Op. [8] and [6]) that the publication disclosed the invention

3. If an outright inter-Circuit conflict precipitates certiorari, the whole thing may be revived if the Supreme Court were to exercise its extraordinary powers to reach back to rectify past mistakes. Cf. United States v. Ohio Power, 1957, 353 U.S. 98, 77 S. Ct. 652, 1 L. Ed. 683; Cahill v. New York, New Haven & Hartford R., 351 U.S. 183, 76 S. Ct. 758, 100 L. Ed. 1075.

4. This is apparently an inescapable consequence of our case or controversy approach, and the hierarchial independence of each of the Circuits. The Eighth Circuit recognizes that it must decide for itself. Aeration Processes v. Lange, 8 Cir., 1952, 196 F.2d 981, 982, cert. denied, 1952, 344 U.S. 834, 73 S. Ct. 43, 97 L. Ed. 649. And doing so it has just recently differed with us. Graham v. John Deere Co.; John Deere Co. v. Graham, 2 Cir., 1964, 333 F.2d 529, 142 USPQ 243, cert. granted, 1965, ____ U.S. ____, ____ S. Ct. ____, 13 L. Ed. 2d 553, hold invalid the Graham patent held valid by us in Jeoffroy Mfg. Inc. v. Graham, 1955, 219 F.2d 511, cert. denied, 1955, 350 U.S. 826, 76 S. Ct. 55, 100 L. Ed. 738; Graham v. Cockshutt Farm Equipment Co., Inc., 5 Cir., 1958, 256 F.2d 358. Hopefully all will soon know whether that patent is or is not valid when the Supreme Court articulates the standards as it is bound to do in deciding the above case and Calmar, Inc. v. Cook Chemical Co., 8 Cir., 1964, 336 F.2d 110, cert. granted, 1965, ____ U.S. ____, ____ S. Ct. ____, 13 L. Ed. 2d 967; and Adams v. United States, Ct. Claims, 1964, 330 F.2d 622, 141 USPQ 361, cert. granted, 1965, ____ U.S. ____, ____ S. Ct. ____, 13 L. Ed. 2d 968.

to invoke the absolute bar of § 102(b), 35 USCA § 102(b). We uphold the Trial Judge as to 60(b) but reverse as to § 102(b) thereby reinstating the judgment upholding validity, infringement and the award of damages.

The 60(b) Relief

We sent the case back to determine whether the celebrated brochure (described in Op. [8] 415) was in fact published at or before the July 1948 Chicago Road Show and, if so, whether circumstances of earlier non-disclosure or concealment of such fact satisfied requisite equitable consideration warranting 60(b) relief. The Patentee was implicated directly in this since its manager, Williamson (also a co-patentee), in the June 23, 1959 affidavit opposing reopening of the case by the Sixth Circuit, swore (Par. 7) positively that such brochure "was not prepared or distributed by [Patentee] until long after said roadshow."

Where in the 8th Circuit appeal the finding of 1948 publication was not attacked (Op. [8] 415), the fact has now been irrefutably established as a fact. In the course of November 1963 pre-trial discovery for the 60(b) hearing then fixed for December 16, 1963, there was extensive inquiry both as to what had been discovered as to *when* the brochure had been published and, also, the nature and scope of the search. The evidence detailed the unsuccessful efforts conducted on a dual front under the direction of Williamson and the comptroller in 1959 in preparation of the Minnesota trial (Op. [6]) where the § 102(b) issue was timely and directly raised for the first time. The upshot of that investigation was that no record, accounting or otherwise, could then be located showing the time of printing or even the identity of the printer. With our 1963 remand (Op. [9] 601-2, 605, 609-11) again focusing

attention on it, the top owner-management of Patentee, naturally alarmed at the increasing use of opprobrious descriptives charging conscious misconduct, renewed the efforts with vigor through the new comptroller, Moberg, who had since replaced his less competent predecessor. He uncovered in a loft two bundles of old discarded bookkeeping cash disbursement journals, one of 212 pages, the other of 552. Study of these revealed 36 references to printers or advertising agencies, including an item of $178.30 with the Gile Letter Service which was verified through checking of the Invoice Register. Although Patentee had done no business with Giles since 1952, Moberg, going to Giles' office, located a Kardex accounts receivable card which showed an entry "50 ton compactor" for the invoice payment of $178.30. It was now certain that the brochure had indeed been printed and distributed not later than July 1948. Patentee's counsel immediately notified Infringer's counsel of the fact which at every stage thereafter it formally and unequivocally acknowledged.

Out of the Patentee's records, the Williamson June 23, 1959 affidavit was therefore proved to be incorrect. It was untrue. But was it something more? Deliberate? Knowingly false? Although this record details other circumstances which raise questions why the fact was not earlier uncovered, we think the record as a whole, F.R.Civ.P. 52(a), does not warrant the Trial Judge characterizing this affidavit as a "false statement" and "manifestly untrue and knowingly [so] made." It may have been given too hastily as a response to the efforts to reopen the 6th Circuit decision (Op. [4]) and perhaps too much reliance was put on the earlier escape clause in Par. 3 of the affidavit that "the following information * * * is true to the best of my knowledge and belief." But

we do not think it shows a deliberate evil purpose to misstate or conceal or thereafter engage in foot-dragging lest the truth might be uncovered.

But this does not alter granting 60(b) relief. Because of the unique factors of this case and this type of public interest litigation which we previously discussed at length (Op. [9] 609-11) 60(b) relief was justified, if not compelled. Stated with such positiveness, the affidavit, accompanied by strong memorandum briefs (see Op. [9] 603-5) undoubtedly had a decisive impact on the 6th Circuit. The 6th Circuit's reliance on its literal truth closed the door there, and by res judicata here. The effect was the same whether there was evil, innocent or careless, purpose. In either event it was the action of the party taken while the case was still "alive" and when had the truth now revealed been disclosed, quite a different result might have come about.

Expunging now the aspersions of purposeful misconduct, we are nonetheless certain that the broad reach of 60(b) reaches this far. The Judge was correct, therefore, in granting 60(b) relief to introduce belatedly, but permissibly, the new defense of § 102(b) prior publication.

§102(b) Prior Publication

In the Eighth Circuit case, Judge Nordbye held that the brochure sufficiently disclosed the invention (Op. [6]) and applied the bar of § 102(b)[5] The Eighth Circuit affirmed largely on the ground, as we read its opinion, that this was a question of fact (Op. [8] 416) as generally identity is. See *Bischoff* v. *Weathered*, 1869, 76 U.S. 812,

5. 35 USCA §102: "A person shall be entitled to a patent unless—* * * (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States * * *."

814, 19 L.Ed. 829; *Southern Implement Mfg. Co., Inc. and George Partin* v. *McLemore*, 5 Cir. 1965, ... F.2d ..... [No. 21458, ...]. While highly persuasive on principles of stare decisis, the Eighth Circuit's decision does not eliminate our judicial travail since we have the duty of reaching our own independent decision on the merits of the case as between these parties and on this record, *Pierce* v. *Aeronautical Communications Equipment, Inc.*, 5 Cir., 1962, 307 F.2d 790, 134 USPQ 533, even though as it did there, this brings about diametrically opposed decisions on validity of the same patent against the same attack. And the Patentee urges, successfully it turns out, that there is a critical difference in this record in the form of expert opinion testimony with accompanying charts demonstrating element by element the deficiency in the brochure disclosure of the claimed invention.

One of the reasons there have been, and will be, differences is the inherent difficulty in the decisional process brought about largely by the unavoidable wordiness of controlling legal principles. In the final analysis, the rules support the result, seldom point the way to decision.

At this late date it is an affectation to pick out the threads which now make up this fabric by citation of case by case. If there is any disagreement in the statement of principles—not their application—we cannot discern it. Consequently, for our purposes we think it best to draw on the well recognized treatise[6] for the synthesis of this accumulated wisdom.

One notices a principal, recurring theme with the differences being in verbal shadings, new figuratives. "A prior printed publication to defeat a patent must describe the invention in such full, clear and exact terms as to

6. The quotations are from 1 Deller's Walker on Patents §§60, 61, 78, 79, 80 (1964). Page references are indicated, e.g. (277).

enable any person skilled in the art to which it relates to practice the invention." (277) "It must be in such full, clear and exact terms as to enable one skilled in the art to practice the patented improvement without the exercise of inventive skill of his own and without assistance from the patent claimed to have been anticipated." (278) In another phrasing to meet the test, the "prior description must disclose clearly, truly, and fully what the subsequent patentee invented and accomplished." (278) Another puts it, "Such description must exhibit a substantial representation of the patented invention." (277) In the words of the celebrated case,[7] the revelation must be "in such full, clear and exact terms as to enable any person skilled in the art or science * * * to make, construct, and practice the invention to the same practical extent as they would be enabled if the information was derived from a prior patent." (286)

Of course, the ordinary skill in the art is not ignored. It is very much a part of the test. Nevertheless we must "read" the publication as we would a prior patent since the "same rules as to the sufficiency of the description in a patent apply to a printed publication in order to constitute it an anticipation." (280) The result is that "Essential elements cannot be read into the description, nor can information which it does not give." (277) But if the essential elements are revealed, the "fact that the prior art description did not use the exact words employed in the claims of the patent in suit" is "not determinative" since "the real question" is "whether the substance of the description was the same." (290)

These principles, the function of §102(b) and its predecessors, the development of the case law both in Court and the Patent Office are exhaustively analyzed by Judge

7. Seymour v. Osborne, 1870, 78 U.S. 516, 20 L. Ed. 33.

Arthur M. Smith's opinion for the Court in Application of Grice, CCPA, 1962, 301 F.2d 929. He uses an acquisitive figure, the test being whether the ubiquitous skilled artisan using his own talents "could take" the "teachings" of the prior publication "and be in possession of the invention." 301 F.2d 929, 936.

The problem ends as it began: does the brochure reveal "in such full, clear and exact terms as to enable any person skilled in the art * * * to make, construct and practice *the invention* to the same practical extent as * * * if the information was derived from a prior patent"?[8]

What is the invention?—not merely as to the device, but what is it the law regards as the "invention"? Here perhaps we get some help. For while the specification of the patent is indeed important, it must conclude with a claim[9] and we, and all other courts, have often held that it is the claim of a patent that measures the invention[10] so much so that each is (and must be) separable and distinct, each defining in effect a separate invention and each treated in law as a separate grant.[11] This means every element of each patent claim is deemed to be material to the inventive concept[12] and, of course, the Patent Office

8. Seymour v. Osborne, supra, note 7.

9. 35 USCA §112. "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

10. Continental Paper Bag Co. v. Eastern Paper Bag Co., ..., 210 U.S. 405, 28 S. Ct. 748, 52 L. Ed. 1122; Coulter v. Eagle & Phenix Mills, 5 Cir., 1929, 35 F.2d 269, 270; U. S. Industries v. Otis Engr. Corp., 5 Cir., 1958, 254 F.2d 198, 201.

This is reiterated in the Patent Office Rules of Practice, Rule 75(a).

11. Cameron Iron Works v. Stekoll, 5 Cir., 1957, 242 F.2d 17; Hall v. Keller, 5 Cir., 1950, 180 F.2d 753, citing Steimnetz v. Allen, 1904, 192 U.S. 543, 24 S. Ct. 416, 48 L. Ed. 555.

12. U. S. Industries v. Otis Engr. Co., 5 Cir., 1958, 254 F.2d 198.

history is relevant if questions arise as to scope or interpretation of claims.[13]

In this process of matching the brochure against the claims, several things bear explaining. First by res judicata from the Ohio judgment (Op. [1] and [4]), the patent is conclusively deemed to be valid so far as invention, novelty, and obviousness are concerned.[14] Second, it is conceded on this record, as in the Eighth Circuit record (Op. [8]), that the display of the compactor at the Chicago July 1948 Road Show did not constitute prior public use or sale under § 102(b). Consequently, the comparison is against the publication only, unaided as it otherwise would have been—perhaps sufficiently so—had the theoretical inventor made the theoretical inspection of a machine he theoretically knew about. Third, the inquiry must be one of substance, not mere technical expression, since the statutory bar is hardly to be confined to the sterile precision of claim jargon. The law contemplates, therefore, that when the prior publication is not in the form of a formal patent, it has been written, not in patentese,[15] but in ordinary language with here and there an occasional comma or a period as a breathing spot.

Some slight addition to the rather detailed description of the brochure (Op. [8] 415-16) is helpful. The photographs did not reveal the interior of the body (box) or any of the structure within the arched transverse recess. The four supporting-compacting tires were well portrayed

13. Edward Valves v. Cameron Iron Works, 5 Cir., 1961, 286 F.2d 933 at 943; Zachos v. Sherwin Williams Co., 5 Cir., 1948, 164 F.2d 234; Inglett & Co. v. Everglades Fertilizer Co., 5 Cir., 1958, 255 F.2d 342.

14. The Eighth Circuit (Op. [8] 414 and [6]) is in agreement with the Sixth Circuit on this. We have many times pointed this out (Op. [9] 610, 598).

15. Thermo-King Corp. v. White's Trucking Service, Inc., 5 Cir., 1961, 292 F.2d 668, 675 n. 9.

by side, oblique, and rear-end views. The latter showed the bottom third of the rear side of the four tires, the left pair tilted to conform to the sharply raised elevation of the ground on that side, the body (box) remaining horizontal.

The drawings on the reverse page were of side and birds'-eye views portraying generally the elevations shown in drawings Figs. 5 and 6 of the patent. The birds'-eye view showed apparently exterior frame (or side plate) members with only two transverse members, one at the front edge of the arch recess, the other at its rear edge. The wheel-tires were shown in position but no axle structure, either transverse, or fore-and-aft, was shown. The side view showed the plate forming the side with the arch recess. The draw means was a horizontal member running from the top front end of the body (box) to the tow-dolly. Midway between the front edge of the box and dolly, a member ran diagonally downward and joined a piece just forward of the front box plate. No extension of this member through the box was indicated. The arch showed space between the top edge of the wheel-tire, also a transverse plate-member, one at the forward, the other, the after, edge of the recess to which was affixed some character of mounting from which top and bottom horizontal lines ran to the tire edge indicating a fore-aft structure of some kind.

The testimony offered by the Infringer, through witnesses—some interested, some disinterested, all experienced presumably competent engineers, draftsmen, and practical equipment builders, and whose general credibility was for the Trial Judge, F.R.Civ.P. 52(a)—took the following general pattern which in our approach, we must, and do, credit fully for what it says. Upon being shown the brochure, each swore, in effect, that as one skilled in

the art he "could build a compactor of the *type* it shows from the information the [brochure] contained",[16] or if "asked to build a 50-ton compactor of this *sort* it illustrates and describes," he would "be able to do it",[17] or he could "build an earth compactor of the *sort* it shows" or at least a "machine * * * comparable with it."[18] In more elaborate terms another said the brochure "describes, to a person skilled in the art, sufficient information to build a 50-ton compactor of the *type* that this [brochure] purports to *illustrate* and describe."[19]

But nearly all of them disclaimed ever having seen the patent. Consequently, they could express no opinion as to whether the "sort" or "type" of compactor "illustrated" or "described", they would build from the teachings of the brochure, was that revealed by the patent. More important, cross-examination[20] demonstrated that a number of things discussed in the patent could nowhere be seen.

It is at this point that the testimony of the Patentee's engineer-lawyer-expert witness becomes so important. Its significance rests, not on credibility choices in the cruder sense, nor for that matter differences on what one skilled in the art would think of in the way of mechanical equiva-

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16. Witness Moore R. 20.

17. Witness Mims R. 31-32.

18. Witness Williams R. 39.

19. Witness Keppler, Chief Engineer of Tampo, a defendant in the yet untried infringement suit brought by Patentee in the Western District of Texas. (See Op. [9] 610, 603 n. 15). Similar testimony came also from Falke, employed by Browning, the successful 8th Circuit litigant (Op. [8] 414 and [9] 603 n. 15). [R. 192]

20. The Patentee's brief reminds us of what all advocates know, some from bitter experience: "a case that can be made out in all its elements by cross-examination of opposing witnesses is a strong case." Eibel Process Co. v. Minnesota & Ontario Paper Co., 1923, 261 U.S. 45, 53, 43 S. Ct. 322, 67 L. Ed. 523.

lents of distinctive elements in the claim. Rather, it rests on the analysis, element by element, carefully articulated and graphically portrayed,[21] demonstrating the limitations imposed during the Patent Office prosecution and the presence or absence of those in the brochure. Focusing sharply as it did on these elements, it also exercises the real issue. The problem of identity of invention does not depend on a disclosure of body dimensions, tire sizes, or the like, none of which is specified in the claims. Identity, rather, depends on whether or not the brochure discloses structural features and characteristics that are precisely defined in the claims.

Thus, as to claim 1 (substantially set forth in (Op. [4] 777) of the three main elements, only two—(1) a hollow body member with transverse arched recess, and (2) axially aligned series of wheels mounted in the recess are present. Completely missing, and nowhere to be seen in photographs, drawings, words, or implication is element (3). This is the longitudinal draft beam which is both claimed and precisely described in the specification.[22] The conclusion is inescapable that if the drawings of the brochure included a draft beam, it would (but did not) show clearly in full lines in the plan view drawings on the back page as it does in Fig. 2 of the patent. And when the testimony of the Infringer's witnesses (see, e.g., notes

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21. See especially PX-56A, PX-56B, PX-57, PX-58, PX-59, PX-60. In Bryan v. Garrett Oil Tools, Inc., 5 Cir., 1957, 245 F.2d 365, 374, we pointed up the value of these element-by-element aids to understanding; and see also Bryan v. Sid W. Richardson, Inc., 5 Cir., 1958, 254 F.2d 191, 192; and Thermo-King Corp. v. White's Trucking Service, Inc., 5 Cir., 1961, 292 F.2d 668.

22. As to it, the claim reads: a "draft beam extending longitudinally through the lower part of the body, centrally thereof [and] traversing said arched recess between two of such wheels and rigidly connecting opposite wall portions of the recess." This is illustrated in Fig. 1 and 2 and Spec. Col. 3, lines 9-40. It is identified as Item 11 or draft beam 11, 14-15.

16, 17, 18, and 19, *supra*) is analyzed carefully, none refuted this fact.[23]

The deficiencies are even more marked as to claims 2, 3, and 4 as to which extensive limitations were imposed as a condition to the grant of the patent.[24] These claims are briefly paraphrased by the 6th Circuit (Op. [4] 777). Fully conscious that an effort to portray this device in ordinary terms risks inaccuracy, we would thumbnail it this way. They first detailed the body structure (less draft beam) and the two pair of pneumatic tired wheels. Next they described the shaft (axle) for mounting each pair of wheels, the fore-and-aft rocker support to which the two shafts (axles) were to be affixed and the method of mounting the ends of these supports in bearings to permit rotation. Although the axles (shafts) for the wheels were each rigidly fixed to the fore-and-aft rocker supports, this permitted the wheels to oscillate. In addition, some of these claims described the structure of the

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23. Neither as to claim 1 or 2, 3, and 4 do we ignore the Williamson June 23, 1959, affidavit. Par. 2 of Judge Nordbye's order (Op. [6]) inquired: "Whether any pneumatic roller compactor displayed by [Patentee] at the aforesaid road show *corresponded substantially* with the disclosure in United States Letters Patent No. 2,610,557." Williamson's answer was: "5. Answering Paragraph No. 2 of the order the aforesaid number 1 machine as displayed at the July 1948 road show, did correspond substantially with the disclosure in U.S. Patent No. 2,610,557, but such disclosure (drawings and specification) were not prepared until after the aforesaid tests have been completed, nor until the aforesaid effects were corrected * * *."

We reject this as immaterial since public *use* or *sale* is not urged. What was disclosed by the machine itself has nothing to do with what the brochure reveals as to those elements which are not thereby disclosed no matter how readily discernible they might have been to one crawling in, on, under or around the machine on display.

24. After rejections, the Examiner finally allowed the original claims 2, 13, 14, and 15 which were renumbered 1, 2, 3, and 4. Originally three claims directed to combinations including the draft beam structure (2, 3, and 4) but only 2 was allowed to become claim 1.

fore-and-aft supports in terms of strength members against compression forces on the lower leading, and back, edges of the arched recess.

Out of elements running from 7 (in claim 2) to perhaps 10 (in Claim 4) as many as five distinctive elements were not revealed by the brochure. It does, of course, show (1) the unitary hollow body with transverse arched recess and (2) the two pair of pneumatic tired wheels, and one might assume, although not expressly disclosed, that it showed (3) a shaft in the recess for mounting the wheels. But it nowhere showed (4) the fore-and-aft rocker beams running between each pair of wheels and mounted in bearings (5) fixed to the transverse bearing beam (6) in such a way as to allow the wheels to oscillate and, at the same time, serving as a strength member against compression forces against the recess walls.[25]

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25. Thus, e.g., for claim 3 the matters in italics represent limitations imposed in the patent prosecution and not disclosed in the brochure:

"*A shaft in the recess*
for mounting each pair *of wheels*
A fore-and-aft extending *support in the recess*
for each shaft
positioned between the wheels of each pair
with the support oscillatably mounted and
with its axis fixed with respect to the body member,
whereby *the wheels of each pair are free to oscillate about the axis of said supports, and*
A bearing beam
disposed at each lower end of the transverse recess and in which the fore-and-aft supports are mounted,
The wheel supporting shafts being parallel with and equidistantly spaced from said bearing beams * * *."

Of course, it did show that in some way the wheels were bound to be mounted to permit oscillation.

Besides this graphic demonstration, witnesses for the Infringer either admitted, or could not deny, these facts. Thus witness Wood conceded that the rocker beam construction is not disclosed. So did Burcombe. Kaiser professed to disagree, but when pinned down he admitted the bearings are not shown and no fasteners indicated. He just assumed they are there. Similarly, Moore admitted that wheels as shown could be mounted in several different ways and still oscillate. Williams confirmed that he could readily think of three means of oscillating wheels.

It will not do, to suggest, as some of the witnesses implied and the Infringer argues, that anyone skilled in the art would know that wheels had somehow to be mounted on a shaft-axle and all know there are several ways of mounting wheels to permit them to oscillate either singly or in pairs. This patent, as allowed, taught specific means (or their equivalents) for accomplishing this. If one assumes that by merely seeing the drawings of exterior dimensions and photographs of a box-body mounted on rubber tired wheels, the skilled engineer, drawing on his experience, could create this structure, it is difficult to see how a patent could have been granted. The contention is just another plea for disregarding as utterly immaterial those specifically added limitations which were indispensable in securing the allowance of the patent.

The upshot is that on a consideration of the whole record, we regard as clearly erroneous the decision of the District Judge that the brochure disclosed the invention described in the claims. It is so in the sense that taking all of the testimony offered by the Infringer and crediting it 100% plus—both as to what it says and what it does not say—and balancing it against both the factual and expert

testimony of the Patentee, we are left with the certain conviction that this patent which comes to us with its validity conclusively established is not disclosed by the brochure which leaves so many critical elements of the claims unrevealed, *United States* v. *U.S. Gypsum Co.*, 1948, 333 U.S. 364, 396, 68 S.Ct. 525, 92 L.Ed. 746; *Oil Screw Noah's Ark* v. *Bentley & Felton Corp.*, 5 Cir., 1963, 322 F.2d 3; *W.R.B. Corp.* v. *Geer*, 5 Cir., 1963, 313 F.2d 750. It is so also in the sense that this critical fact finding was not made in the light of the correct controlling legal principles. *United States* v. *Williamson*, 5 Cir., 1958, 255 F.2d 512, 515; *McGowan* v. *United States*, 5 Cir., 1961, 296 F.2d 252, 254; *Davis* v. *Parkhill-Goodloe Co.*, 5 Cir., 1962, 302 F.2d 489, 491.

This makes it unnecessary for us to consider the argument urged by the Patentee that the significance of the prior publication under § 102(b) is something quite different from its use as prior art under § 103. Likewise, we need not determine whether we do or do not agree with the Eighth Circuit's disposition of this theory. (Op. [8] 417).

Thus, as must to all living things, an end comes to this case here. At least we hope so. It goes back now for the entry and enforcement of the judgment previously directed (Op. [9] 598-600, 601-11).[26]

REVERSED.

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26. This disposition automatically affirms the Trial Court's refusal to grant equitable relief to the Infringer and the cross appeal is therefore affirmed.

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

October Term, 1964

No. 21470

D. C. Docket No. 7608—Civil Action
BROS INCORPORATED,
Appellant-Appellee,

VERSUS

W. E. GRACE MANUFACTURING COMPANY and
WILLIAM E. GRACE,
Appellees-Appellants.

(AND REVERSE TITLE.)

Appeals from the United States District Court for the Northern District of Texas.

Before TUTTLE, Chief Judge, and BROWN and GEWIN, Circuit Judges.

Judgment

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Texas, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed;

It is further ordered and adjudged that the Appellees-Appellants, W. E. Grace Manufacturing Company and William E. Grace, be condemned, in solido, to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

September 14, 1965

Issued as Mandate:

IN THE

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 21470

BROS INCORPORATED,
Appellant-Appellee,

VS.

W. E. GRACE MANUFACTURING COMPANY and WILLIAM E. GRACE,
Appellees-Appellants.

(AND REVERSE TITLE.)

Appeals from the United States District Court for the Northern District of Texas.

(October 20, 1965)

On Petition for Rehearing

Before TUTTLE, Chief Judge, and BROWN and GEWIN, Circuit Judges.

PER CURIAM:

It is ORDERED that the petition for rehearing filed by W. E. Grace Manufacturing Company and William E. Grace (appellees and appellants) in the above entitled and numbered cause be, and the same is, hereby DENIED.

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

BROS INCORPORATED,
Appellant-Appellee,
v.
W. E. GRACE MANUFACTURING COMPANY and WILLIAM E. GRACE,
Appellees-Appellants.
(AND REVERSE TITLE.)

No. 21,470

Order

The above-entitled cause having come on for consideration upon appellees-appellants' petition for an order staying execution of judgment pending application to the Supreme Court of the United States for a writ of certiorari, and upon the objection of appellant-appellee to granting of the requested stay without posting of full and proper supersedeas security; and the Court having consulted with the parties and having been advised of their agreement:

NOW, THEREFORE, it is hereby Ordered that further proceedings in this cause shall be stayed pending application to the Supreme Court of the United States by appellees-appellants for a writ of certiorari upon the conditions: First, that the filing of such application shall be completed on or before January 18, 1966; and, second, that appellees-appellants shall, within ten (10) days of the date of this Order, deposit with or make available to the order of the Clerk of the United States District Court for the Northern District of Texas at Dallas negotiable security consisting of U. S. Government bonds and/or certificates of deposit on a Dallas bank in the total amount of not less than Two Hundred Thousand Dollars ($200,000.00) at present market value to be applied against any unsatisfied portion of any judgment in favor

of appellant-appellee that shall become final herein, and shall also file with said Clerk a financial statement, to be sworn to by the individual appellee-appellant, and by an officer of the corporate appellee-appellant, showing that appellees-appellants have further assets in hand sufficient to satisfy the presently indicated amount (approximately $240,000.00) of any such final judgment herein together with costs and interest. In the event that the aforesaid principal amount of negotiable securities is not so deposited with the Court Clerk at Dallas then it shall be deposited with not more than two banks or trust companies in Dallas who shall each, by an officer thereof, make a statement, to be filed with the Clerk, as to the nature and amount of the security so deposited with it, and be authorized, upon being informed by the Clerk that the judgment is to be satisfied, to deliver such securities to the Clerk.

This the 8 day of December, 1965.

/s/ John R. Brown
U. S. Circuit Judge

(Filed Dec. 9, 1965)

IN THE

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 19672

BROS INCORPORATED,
Appellant-Appellee,

VERSUS

W. E. GRACE MANUFACTURING COMPANY and
WILLIAM E. GRACE,
Appellees-Appellants.

(AND REVERSE TITLE.)

Appeals from the United States District Court for the Northern District of Texas.

(July 3, 1963)

Before CAMERON, BROWN and WISDOM, Circuit Judges.

BROWN, Circuit Judge: This litigation bearing service stripes from its now second appearance here, *Bros, Inc.* v. *W. E. Grace Mfg. Co.*, 5 Cir., 1958, 261 F. 2d 428, as well as two trips to the 6th Circuit, *Gibson-Stewart Co.* v. *Wm. Bros Boiler & Mfg. Co.*, 6 Cir., 1959, 264 F. 2d 776, cert. denied, 1959, 360 U.S. 929, 79 S. Ct. 1448, 3 L. Ed. 2d 1544, *Wm. Bros Boiler & Mfg. Co.* v. *Gibson-Stewart Co.*, 6 Cir., 1963, 312 F. 2d 385, and an oblique visit more

recently to the 8th Circuit, *Bros, Inc.* v. *Browning Mfg. Co. & Shovel Supply Co.*, 8 Cir., 1963, ... F. 2d ....., 137 U.S.P.Q. 624 [No. 17,169 May 27, 1963], aff'g D.C. Minn. 1962, 134 U.S.P.Q. 231, deals with the validity (and infringement) of Bros Patent No. 2,610,557. The main appeal by the Patentee (Bros Incorporated) presents simple routine accounting questions. The cross appeal of the Infringer (W. E. Grace et al), more complex and intricate, presents difficult problems concerning the extent to which courts within the 5th Circuit may properly re-examine under equitable doctrines an earlier judgment entered in Texas on principles of res judicata on the basis of an Ohio judgment sustaining validity of the patent which was subsequently affirmed by the 6th Circuit under orders denying efforts to reopen the case to prove facts subsequently ascertained by the Minnesota court to establish invalidity of the patent because of prior domestic publication.

Hearkening as we should to the principle epitomized in Justice Story's apothegm that "It is for the public interest and policy to make an end to litigation * * *" so that "* * * suits may not be immortal, while men are mortal." *Ocean Ins. Co.* v. *Fields*, 18 Fed. Cas. 532, we nonetheless conclude that before the curtain falls on this juridical drama, there must be another act.

* * * *

The Infringer's Cross Appeal

II.

While the main appeal presented simple issues of easy resolution, this is far from the case as to the cross appeal. It is complex and difficult. It is difficult because it is again the clash between the strong public policy of finality and repose on the one hand and the lofty appeal of intrinsic justice on the other. Adding greater complexity is the subject

of the litigation—the patent monopoly with its overriding public interest. And sustaining the chain reaction which produces more and more problems in the course of this juridical fission, are divisive elements of res judicata, geography, inter-circuit insularity, and at least the possibility that when the last gong is rung, the patent will have been sustained as to this Infringer-cross appellant only.

The cross appeal is nominally from the final judgment entered on March 9, 1962, fixing damages, costs, etc. which, as modified, we have just affirmed on the main appeal. The error asserted is nominally the failure of the Court to grant the motion for new trial under F. R. Civ. P. 59 filed on March 19, 1962, which the Court denied on April 17, 1962, and as to which Notice of Appeal was nominally given April 23, 1962. We say nominally because this highlights the threshold insistence by the Patentee (cross appellee) that we are wholly without jurisdiction to entertain or consider the substance of the cross appeal. This in turn rests on the contention that this is an attempt to appeal from an order denying a motion for new trial a thing which the cases, often with an uncritical confusion of appealability, reviewability, and the tolling provision of pertinent rules, say may not be done.[6]

We think there is nothing to this jurisdictional challenge. Assuming that the motion is what it says it is—

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6. But see Milton v. United States, 5 Cir., 1941, 120 F. 2d 794; Atlantic Coast Line R.R. v. Mims, 5 Cir., 1952, 199 F. 2d 582; Kanatser v. Chrysler Corp., 10 Cir., 1952, 195 F. 2d 104; 6 Moore, Federal Practice, Par. 59.15, p. 3891 (2d ed. 1952); 3 Barron & Holtzoff, Federal Practice & Procedure, §1302.1 (Wright ed. 1958). "Where the appeal is erroneously taken from the order denying the motion, rather than from the judgment, the sound course undoubtedly is to treat this technical error as harmless, and to consider the appeal as if it were from the judgment,[17.9] though there is some suggestion that in such circumstances the court may consider only those errors which were pointed out in the motion for a new trial." p. 347. Footnote 17.9 cites Atlantic Coast Line R.R. v. Mims, 5 Cir., 1952, 199 F. 2d 582, 583.

one under F. R. Civ. P. 59, and not (as we later discuss) one which must be regarded as under F. R. Civ. P. 60(b) or an independent equitable proceeding as allowed under 60(b)[7]—the answer is plain. The time for giving Notice of Appeal from the final judgment dated March 9, 1962, was tolled by the timely filing within ten days of the motion on March 19, 1962, F. R. Civ. P. 59(b); 73(a). On April 17, 1962, the motion was overruled, and on April 23, 1963, written notice of appeal was given.[8]

No question exists that the time for giving notice of appeal was tolled up to April 17. Reading the notice of appeal which was timely given in the spirit which the Rules always require as *Foman* v. *Davis*, 1962, 371 U.S. 178, 83 S. Ct. 227, 9 L. Ed. 2d 222, so recently reflects, there can be no question as to what the cross appellant desired to bring up for review. Its complaint is that it is now under the burden of a final judgment (then for $52,000) plus a permanent injunction against future infringement. The specification of the order denying the motion under Rule 59 served a double role. First it showed that the notice dated April 23 was timely, i. e., within 30 days. More important,

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7. If in reality the motion was one under 60(b), the denial of April 17 was final and appealable. Greenspahn v. Joseph E. Segram & Sons, Inc., 2 Cir., 1951, 186 F. 2d 616. 3 Barron & Holtzoff, Federal Practice & Procedure § 1332, p. 434 (Wright ed. 1958); 7 Moore, Federal Practice, Par. 60.30, p. 334 (2d ed. 1955); cf. Saenz v. Kenedy, 5 Cir., 1950, 178 F. 2d 417. If it more properly constitutes an application to this Court for leave to institute a partial retrial under 60(b) or as an independent equitable action, a notice of appeal is not a prerequisite and the matter is properly before us.

8. It stated that Infringers hereby "appeal to the United States Court of Appeals * * * from the Order entered * * * on April 17, 1962, denying the Motion by Defendants under Rule 59; and hereby petition the aforesaid Court of Appeals to suspend the Final Judgment entered herein on March 9, 1962, and to authorize reopening of the Interlocutory Judgment heretofore entered on February 17, 1958, for the purpose of granting a partial new trial devoted to the issue of statutory invalidity of the patent * * *."

it showed that the final judgment dated March 9 (temporarily suspended for purposes of appeal until April 17) was erroneous for the reasons pointed out in the motion for new trial under Rule 59.

This Court therefore has jurisdiction, and the Patentee's motion to dismiss the cross appeal, carried with the case by prior order, is accordingly overruled.

III.

Severely capsulated, the basis for the extraordinary motion seeking relief[9] from the judgment sustaining validity[10] and infringement is this. On the eve of the issuance of the mandate by the 6th Circuit, the Infringer discovered through its new (and present) counsel that a printed brochure depicting the machine, describing it rather fully and indicating a specific sales price was publicly distributed at the "Road Show" of the American Road Builders Association held at Chicago in July 1948. If publication were established, it could, or at least might, be decisive, especially in light of the admitted display of the machine itself on the show grounds. Dates are of critical importance since with the patent application being filed November 17, 1949, no patent could validly issue if in fact "the invention was * * * described in a printed publication in this * * * country or in public use or on sale in this country, more than one year prior to the date of the application * * *." 35 USCA § 102(b). In other words, if the time was fixed at July 1948 and in a substantive sense it was judicially determined that "the invention was * * *

9. For these purposes we use the term broadly without regard to whether the procedural device is, should, or must be under Rule 59, 60(b), independent equitable action either in Texas or Ohio, or both.

10. The money judgment is likewise attacked.

described in [the] publication * * *," the patent, no matter how meritorious intrinsically, would be invalid because of a positive statutory infirmity. The matter of *time* and *substantive content* is no longer open to dispute since Judge Nordbye after a full trial in the Minnesota litigation has determined that the patent is invalid by reason of this publication in July 1948. Consequently, the theory concludes, neither the decree in the Texas case nor in the Ohio case on which it rests should be given further effect if—by some appropriate procedure—it is determined in the Texas case as between these parties that the patent is invalid by reason of this prior publication.

By whatever name finally called, it is evident that the Infringer seeks equitable relief. What relief, where and how obtained, its extent and nature, must of necessity be determined by the particular facts. They will illumine what is otherwise a dark and tortuous path.

IV.

This too begins in the beginning.[11] In 1954 the Patentee

11. The factual material comes from our present record as supplemented by that filed with us from the 6th Circuit and the briefs and records filed in the 8th Circuit. Pursuant to our request made on oral argument, the parties by stipulation have filed these papers with us. Urging a stipulation to eliminate questions of authenticity, our letter-order expressly reserved to each of the parties the unrestricted right to contest here or elsewhere either the power of this Court or the propriety of its exercise to obtain and consider such materials. The Infringer urges none. The Patentee objects because "the additional materials * * * are not relevant to any issue in this appeal unless some statute or rule gives the Court jurisdiction over the attempted appeal by the [Infringer] from the District Court's denial of a new trial. We have found no such statute or rule." The Patentee's objection on the ground that we lack jurisdiction was overruled in part II above. Treating this as a request by the Infringer for us to grant leave to file a 60(b) motion, this Court has the right to be fully informed of all that has taken place, not to determine it finally, but to decide whether a 60(b) hearing should be held below. "The hearing conducted by the appellate court on the petition, which may be filed many years after the

filed the Ohio suit against one of Infringer's distributors. Judgment was entered sustaining validity and finding infringement in December 1957. Appeal was taken to the 6th Circuit. In the meantime the present suit was filed in Texas. On February 17, 1958, summary judgment was entered on the basis of res judicata sustaining validity and infringement. *Bros, Inc.* v. *W. E. Grace Mfg. Co.*, D.C. Tex., 1958, 158 F. Supp. 786. On November 26, 1958, and prior to decision by the 6th Circuit, we affirmed this basic holding, but modified and reversed for an accounting.[12] Shortly thereafter the 6th Circuit affirmed the underlying Ohio judgment in February 1959.[13] On the very next day following denial of certiorari, the Infringer on June 30 filed a motion to stay and to modify the mandate.

Between that date and November 16, 1959, the Infringer filed two further applications with the 6th Circuit to modify and recall its mandate and one with the District Court requesting stay of accounting.[14] Each of these ap-

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entry of the challenged judgment, is not just a ceremonial gesture." Hazel-Atlas Glass Co. v. Hartford-Empire Co., 1944, 322 U.S. 238, 248, 64 S. Ct. 997, 88 L. Ed. 1250. In an effort to expedite and end this costly litigation, see 3 Barron & Holtzoff, Federal Practice & Procedure, § 1332, p. 437 (Wright ed. 1958), we have no doubt as to the propriety of our considering these materials. Additionally, the motion of April 19, as well as earlier motions in the Texas case, refer specifically to prior actions in the Ohio and Minnesota cases. In determining what we or the Texas District Court can do under a judgment imposed by res judicata, it is appropriate to know what the Ohio Court has done, or might do. In any event we do not undertake finally to evaluate these developments except insofar as they do or do not show probable grounds for further judicial inquiry as to the truth and its legal significance.

12. Bros, Inc. v. W. E. Grace Mfg. Co., 5 Cir., 1958, 261 F. 2d 428.

13. Gibson-Stewart Co. v. Wm. Bros Boiler & Mfg. Co., 6 Cir., 1959, 264 F. 2d 776, cert. denied, June 29, 1959, 360 U.S. 929, 79 S. Ct. 1448, 3 L. Ed. 2d 1544.

14. On July 11, 1959, the Texas Court in the instant case stayed the accounting ordered by us pending determination of these various applications by the 6th Circuit.

plications was denied, the last by District Judge Jones on November 16, 1959.

In the meantime on June 8, 1959, a declaratory judgment action was brought in Minnesota.[15] The plaintiffs there, though represented by the same counsel, are not in privity with the Infringer. The Minnesota suit by pretrial discovery and trial has provided the machinery to develop the full facts on prior publication. This was affirmatively disclosed in the several applications made to the 6th Circuit. We need not discuss these applications with annexed affidavits in any great detail. Each set forth factually with a number of contemporary commercial photographs the display of machine No. 1 at the "Road Show" held at Chicago in July 1948. Most important, each attached photostatic copies of the elaborate printed brochure.[16] Annexed affidavits from disinterested witnesses fixed the time as July 1948 (as all parties now seem to agree) even though the moving papers showed that on the initial trial in the Ohio District Court, casual reference as to other matters had erroneously referred to the "Road Show" as occurring in July 1949. It is significant, however, that in the supporting papers for the initial

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15. This was instituted by Browning Manufacturing Company and Shovel Supply Company, Inc., two Texas corporations. Each had been threatened by the Patentee with formal notices of infringement. See Bros Inc. v. Browning Mfg. Co. & Shovel Supply Co., 8 Cir., 1963, ____ F. 2d ____ [#17,169 May 27, 1963], affirming the judgment of the District Court declaring the patent invalid (see note 25, infra).

16. The cover piece bore in large print "50 Ton Compactor with oscillating wheels" and identifying it with Bros manufacture. The back sheet had birds'-eye and profile sketches with and without hookup to a tractor. The inner pages had four photographs, two profile, one oblique, and one from rear end. Detailed specifications were printed between the pictures covering weight, capacity, weight loaded, tire size, body capacity, overall dimensions, etc. This sheet also stated "Price $12,500.00 f.o.b. Minneapolis, Minn."

This same brochure appears in our record as Defendant's Exhibit No. D.

application, specific reference was made to the pretrial orders entered by Judge Nordbye and the sworn responses of Archie O. Williamson, a director of Patentee, manager of the road construction division and, in his own words, one "probably more familiar with the background and developments of" this patented machine "than any officer or other employee of the corporation." In answer to one paragraph of the order, this affidavit affirmed that the machine was displayed at the July 1948 "Road Show," and that it "did correspond substantially with the disclosure in U.S. Patent No. 2,610,557 * * *" subsequently applied for on November 17, 1949. Most important, par. No. 4 of the order required the Patentee to state under oath "whether [it] caused to be prepared and publicly distributed at the [July 1948] road show an advertising folder" in the form described in note 16, supra, a copy of which was attached. In the light of subsequent developments, a court might well conclude that there was a positive misrepresentation of the true facts. The affidavit stated that Patentee "did not cause to be prepared and publicly distributed" this brochure "at the [1948] road show." Rather, the affidavit continued, "Said folder was not prepared or distributed by defendant [Patentee] until long after said Road Show."

This first application was denied by a brief, unpublished per curiam order July 30, 1959. On August 26, 1959, a further application to recall and modify the mandate was filed. Attaching more affidavits of outside witnesses showing display of the machine and distribution of the brochure at the 1948 "Road Show," the most significant thing was the statement as to Williamson's pretrial deposition testimony in the Minnesota case. On the preceding day, August 25, 1959, so the application stated, Williamson finally testified that despite the categorical statement made in his earlier affidavits that the brochure was pub-

lished "long after said road show," he now did not know whether it was printed before, during, or after the show. But the Patentee still disputed the July 1948 date. Just as it had earlier referred to the competing affidavits of Williamson and others, that "one of the two affiants is mistaken or is making a false statement under oath," the Patentee's responsive memoranda asserted that Williamson's testimony was being quoted out of context. The implication was plain of course: Williamson's affidavit fixing the publication long after July 1948 was the truth, the challenge false. The extensive memoranda briefs also covered, not only the factual dispute as to *time*, but the substantive significance of the brochure as a description of the invention under §102(b). This application too was overruled October 1, 1959.[17] Application for reconsideration was then filed on October 8, 1959, and on the same date application was made to Judge Jones to stay the Ohio accounting proceedings. With no new factual information, but further memorandum argument and reargument, the 6th Circuit denied this on November 13 on the basis of the order of October 1, with the further direction that "it is hereby ordered that the mandate of this court be complied with forthwith." On November 16, 1959, Judge Jones by an order briefly reciting these developments and stating "I can find neither basis nor power for this court to review what the Court of Appeals already has concluded" and "Rule 60 hardly is appropriate where

17. The brief unpublished per curiam described it as a "petition * * * to modify the mandate * * * based upon a claim of recently discovered evidence and appellee's [Patentee's] suspect oath and affidavit." The order recited that the Infringer claims that it "has obtained new and corroborative evidence of a printed advertisement and offer for sale" of the machine "more than a year prior to the filing of the application * * *." It then concluded, "In view of the availability of the claimed material in earlier proceedings, and our judgment that the additional affidavits fall short of a sufficiency to justify review, appellant's [Infringer's] motion for recall and modification of the mandate in this case is refused.

the reviewing court has denied the same relief as is sought by the request here" denied application for stay and ordered the accounting proceedings to go forward at once.[18]

With things at an irretrievable end in Ohio, developments are confined to Texas and Minnesota. Lashing out in every and any forum open, the Infringer on December 10, 1959, filed in the Texas case, a petition to reopen the former decree of February 17, 1958, sustaining validity and infringement and simultaneously opposed the proposed order appointing a Master to conduct the Texas accounting. These were a substantial rehash of the factual disclosures and contentions in the July-November 1959 applications made in the Ohio courts, together with current developments in the Minnesota litigation.[19] These motions were denied and the Texas accounting hearings proceeded. On December 21, 1961, the Master made his report. On March 9, 1962, the District Court, with modifications discussed in Part I confirmed the Master's report and entered final judgment for the Patentee against the Infringer.

Meanwhile, back in Minnesota, Judge Nordbye had on February 21, 1962,[20] held the patent invalid for prior pub-

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18. In the hearing before the Texas Master, the record of the Ohio Master's proceeding was expressly incorporated. Our record therefore reflects that the Ohio final judgment of October 17, 1961 (affirmed Wm. Bros Boiler & Mfg. Co. v. Gibson-Stewart Co., 6 Cir., 1963, 312 F. 2d 385), allowed $2,314.50 to the Patentee for "attorney's fees for the proceedings from July 1, 1959, through November 16, 1959." In response to questions at our bar, counsel for Infringer considers that further efforts to secure relief in the 6th Circuit or, by its leave, in the Ohio District Court, will subject it to the risk of additional court-imposed attorney's fees.

19. These papers charged that the Patentee "comes to this Court with unclean hands, through reliance upon a previous record made solely by a knowingly irresponsible witness * * *" and "seeking the Court's aid in consummating a constructive fraud." In concluding the motions, Infringer's counsel categorically recognized "the severe character of the * * * charges brought" by the motions which they did "not make * * * lightly or with pleasure," but out of a sense of responsible duty to have the case reopened.

lication for more than a year. Moving with characteristic tenacity, the Infringer then filed in the Texas case what it describes as its "motion * * * under Rule 59," March 19, 1962. This motion supported by annexed affidavit[21] and a copy of Judge Nordbye's opinion, though denominated as under Rule 59, was considerably broader.[22] In overruling it, Judge Davidson certainly treated it as the equivalent of one under 60(b) or an independent equitable proceeding.[23]

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20. Reported as Browning Mfg. Co. & Shovel Supply Co. v. Bros, Inc., D.C. Minn., 134 U.S.P.Q. 231.

21. The affidavit incorporated in some detail and by express reference all of the prior July-November 1959 developments in the 6th Circuit. It pointed out Williamson's earlier affidavit that the brochure "was not prepared or distributed * * * until long after said Road Show." As to this it stated flatly that in the Minnesota case, the Patentee was not "able to produce a shred of evidence in support of [this] affidavit statement" and that if "affiant Williamson" on behalf of Patentee "had not * * * denied" the distribution in 1948, the 6th Circuit "might well have reached a different conclusion."

The papers also showed the pendency in the Western District of Texas of Bros, Inc. v. Tampo Mfg. Co., C.A. 2860, San Antonio Division, for infringement of the same patent.

22. The motion recited that the Infringer "respectfully move this Court, in accordance with * * * Rule 59 * * *, to alter or amend the Final Judgment entered * * * March 9, 1962, or, in the alternative, to open or suspend the same, with leave for application to the Court of Appeals to authorize reopening of the interlocutory judgment heretofore entered on February 17, 1958, for the purpose of granting a partial new trial devoted to the issue of statutory invalidity * * * by reason of prior * * * publication * * *."

23. In orally announcing his decision, after reviewing briefly the prior history of the case in this Circuit, the Judge stated: "The Circuit Court at New Orleans affirmed [Judge Atwell's] decision, therefore we have no discretion except to proceed under the decision as rendered by the Circuit Court, and that was to ascertain the amount of the damage." Elaborating further he went on, "We do not feel we should undertake to withhold any action had under the decision of the Fifth Circuit." But indicating that he was not passing on the intrinsic merits, he continued, "I think, however, the defendant [Infringer] has his remedy, and his remedy should be before that Court [Fifth Circuit] or before the Supreme Court * * *."

In the formal order of April 17, 1962, the order recited "It appearing to the Court that the partial new trial requested by defendant's [Infringer's] Motion is not a matter on which this Court should act at the present stage of the proceedings in this cause, but is rather one for consideration by the Court of Appeals for this Circuit on appeal * * *."

It winds up this extended history to summarize briefly Judge Nordbye's decision. Based on ours and the 6th Circuit's decisions, he sustained intrinsic validity as an invention. But as to prior publication he did two things. First he correctly pointed out that in view of their peculiar nature "the proceedings [to reopen the decrees on validity] in the Fifth and Sixth Circuits on this issue are of little, if any, weight in light of the complete trial * * * before this Court." Next, after an extensive review of the evidence, he held that "the entire record impels a finding that the pamphlet was distributed to a substantial number of people during the show in July, 1948, which was over a year prior to the application for the patent herein." He then examined the substantive content of the brochure and problems related to the display of the machine. Judge Nordbye categorically rejected the contention that the Patentee had abandoned the invention, or that the display with the brochure constituted either a "sale" or a "public use" more than a year prior to the application. 25 USCA §102(b). But after analyzing the brochure including the drawings and the photographs, he concluded that it sufficiently disclosed the invention to one skilled in the art.[24] Since it was a sufficient disclosure of the invention, even though not complete, Judge Nordbye concluded "that the patent must be declared invalid because it was described in a printed publication * * * more than a year prior" to the application.[25]

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24. Cited was Trice Products Corp. v. Delman Corp., 8 Cir., 1950, 180 F. 2d 529, 533; Application of Pappas, C.C.P.A., 1954, 214 F. 2d 172. The 8th Circuit in affirming cited its recent opinion in Collins v. Owen, 8 Cir., 1962, 310 F. 2d 884, 887.

25. We assiduously refrain from intimating any view as to the correctness of this holding since it rests, or may rest, on an evidential record which we have purposely not examined. Except to take note of it, we likewise refrain from attaching any significance to the 8th Circuit's affirmance since it is still subject to review on rehearing or certiorari. For our purposes we regard the Minnesota judgment as an historical fact independent of its intrinsic correctness.

V.

Like Mordecai at the Gate, the peculiar nature of the judgment entered by the Texas Federal Court must constantly be kept in view. That Court is not altogether as free as it might be (nor are we) had the judgment been rendered on the intrinsic merits. On principles of res judicata, it accepted, as it was bound to do, the adjudication of the Ohio court for the very same cause of action between the same parties.[26] Faced with the Ohio judgment, the Texas court had no right to then inquire into the merits, determine whether the Ohio judgment was correct, or ascertain whether the Ohio court would have rendered a different decision had the case been tried differently either on the law or facts.[27]

What it could not do initially, it certainly has no greater right to do by reason of developments subsequent to the rendition of the decree based on the Ohio judgment. Restatement, Judgments, §1, Comment *b*. Consequently, it seems clear that, measured by the historic function of the motion for new trial under F.R. Civ. P. 59, the motion as thus denominated was ineffective.[28] No error was committed in denying it either impliedly or on its merits (or lack of them), or, more likely, out of deference to our mandate. (See notes 22, 23, supra).

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26. Bros, Inc. v. W. E. Grace Mfg. Co., 5 Cir., 1958, 261 F. 2d 428.

27. We are here not speaking of an independent equitable proceeding attacking an earlier judgment of a foreign court. See Restatement, Judgments, § 114, comment d.

28. We need not discriminate between the judgment sustaining validity and the later money judgment since relief as to the former will encompass the latter.

VI.

But it hardly stops there. The relief sought, that to be granted, or within the power of the Court to grant, should be determined by substance, not a label. F.R. Civ. P. 1. In this approach it is plain that the Infringer seeks equitable relief from a judgment which no longer should have legal effect. It does not matter too much whether the object is the Texas judgment which carries the local sanctions of injunction and substantial damages, or the more remote Ohio judgment upon which it is based.

Without examining at this moment the form or name of the procedural remedy, it is equally obvious that the mere fact that through the operation of res judicata a judgment has been entered based upon an earlier judgment does not alter the availability of relief if—and the if may be a big one—(a) parties are available and (b) controlling equitable principles are satisfied by the facts. As to this sort of direct attack[29] a double judgment has no double immunity or double insulation. Two stand no better, no worse, than a single judgment. And, of course, as to a single judgment "A court exercising equitable jurisdiction can properly grant relief from any kind of judgment and against the judgment of any court." Restatement, Judgments, § 114.[30]

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29. See Restatement, Judgments, § 11, Comment *a*, "* * * the taking of independent proceedings in equity to prevent the enforcement of the judgment is a 'direct attack' as the term is used in" this Restatement.

30. See Comment *a*. The equitable decree affects the parties, not the judgment. "Hence a court exercising equitable jurisdiction can give relief against a judgment rendered by any court in any State provided only that it has jurisdiction over the parties." Comment *b, Kinds of Judgments: Patents and Copyrights.* Despite exclusive federal jurisdiction to declare validity or invalidity of a patent "* * * a court of equity can exercise its control over persons although not over the subject matter of a judgment, equitable relief may be granted against the effects of a judgment declaring that a patent * * * is valid or invalid. The ef-

Although it is not likely that there would be a difference between the relief granted by an equity court in Texas, rather than in Ohio, since the judgments concern a matter controlled by Federal law (patents), we have to reckon again with the fact of the earlier Ohio judgment. For principles of conflicts as well as constitutional concepts of full faith and credit restrict the equitable relief granted by a "foreign" court to that which the "home" court would grant.[31] Cf. *Ford* v. *Ford*, 1962, 371 U. S. 187, 83 S. Ct. 273, 9 L. Ed. 2d 240.

VII.

That brings us then to the particular remedy for this case. We reach two principal conclusions. First, the motions as made are the substantial equivalent of ones under 60(b). Second, there is a sufficient probable showing of circumstances which, if finally sustained after proof and hearing, would justify some character of equitable relief.

Without undertaking here to evaluate the substantial criticisms urged by some, we may assume without now deciding what a number of other courts have held, that after an earlier appeal and the issuance of a mandate by a Court of Appeals, permission to file a 60(b) motion in the

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fect of granting a decree in such cases may be to prevent a person who has secured a patent * * * from using it as the basis of a claim or defense; it cannot, however, have the effect of preventing a person from establishing or contesting the validity of the patent * * *." See also in Comment *a*, "Thus, where a State court enjoins a patentee from enforcing an injunction against an alleged infringer, its judgment does not determine that the patent is valid or invalid, but only that, as between the parties, it was improperly obtained (see Comment *b*)."

31. See Restatement, Judgments, § 114, Comment *d*, "A State will give relief against a valid judgment rendered by a court in another State if and only if it would give relief against the domestic judgment similarly obtained." And "* * * relief against a judgment of another State will be given only if the judgment would be subject to some form of relief in the State where rendered * * *." Apart from special statutes, see, e.g., 28 USCA § 2283, this applies to state and federal courts. Comment *e*.

trial court must first be granted by the appellate court.[32] Since Judge Davidson deferred to this Court (see note 23, supra), nothing would be served by remanding this hoary case for him to consider this aspect only to have it return for us to reach the conclusion that the preliminary showing is sufficient.

In view of the express provision of Rule 60 (b), it is not necessary to formally institute an independent equitable proceeding if relief can be granted under subparagraphs (1) through (6) of the Rule. In view of the one-year time limitation under 60 (b) (2), we do not rest our decision on whether all of these papers constitute a showing of "newly discovered evidence which by due diligence could not have been discovered in time to move for a new trial under Rule 59 (b)."[33] Certainly, for the reasons we later

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32. See Geuder Paeschke & Frey Co. v. Clark, 7 Cir., 1961, 288 F.2d 1, cert. denied, 1961, 368 U.S. 826, 82 S. Ct. 47, 7 L. Ed. 2d 30; In re Potts, 1897, 166 U.S. 263, 17 S. Ct. 520, 41 L. Ed. 994; Butcher & Sherrerd v. Walsh, 3 Cir., 1953, 206 F.2d 259; Hazel-Atlas Co. v. Hartford-Empire Co., 1944, 322 U.S. 238, 64 S. Ct. 997, 88 L. Ed. 1250; and authorities collected in 7 Moore, Federal Practice, Par. 60.30(2), pp. 339, 340, Par. 60.42, pp. 907, 908 (2nd ed. 1955). But see the criticism summarized in 3 Barron & Holtzoff, Federal Practice & Procedure § 1332 (Wright ed. 1958). In *Clark* the 7th Circuit took this principle the next step to require leave to file an independent equitable proceeding. As a matter of intra-circuit judicial management, there is perhaps merit in this consistency, but since judgments are subject to independent equitable proceedings at the hands of any court having jurisdiction over the parties (see note 30, supra), a federal Court of Appeals may lack geographical power to protect its mandates.

33. Following our analysis in Part V, we assume that the critical one-year period runs from "one year after the judgment * * * was entered" in the Ohio case. If for 60(b) the "final judgment, order" is the really final, final judgment of October 17, 1961, awarding infringement damages, attorney's fees, costs, etc., see note 18, supra, then the July-November 1959 motions earlier filed in the 6th Circuit asserting these very same contentions were timely (though perhaps premature) under 60(b)(2). If, however, the decree of December 16, 1957, sustaining validity and finding infringement, appealed under 28 USCA § 1292(a) (4) and affirmed by the 6th Circuit is "final" as to this basic phase (cf. Restatement, Judgments, § 41, Comment c), then 60(b) (2) is not available.

discuss, bringing it within subsection (6), if not (3), this was assuredly new evidence having decisive impact depending only on the substantive legal interpretation of the contents of the publication. And on the present showing, especially the Williamson affidavit which as late as July 1959 denied categorically the July 1948 publication date, we would tentatively think that the Patentee is hardly in a position to urge want of due diligence.

Rule 60 (b) (3) also has a one-year time limit. However, we purposely refrain from discussing this subsection separately because the materials suggesting fraud are presently too equivocal. At the same time we do not consider that it is altogether irrelevant in our consideration of relief under subsection (6) for "any other reason justifying relief." In connection with 60 (b) which includes (6), subsection (3) has unusual importance in the policy declaration that for the purposes of this relief, fraud is without regard to whether it was "heretofore denominated intrinsic or extrinsic." In the light of the last sentence of 60 (b), subsection (6) must mean to make available those grounds which equity has long recognized as a basis for relief. 3 Barron & Holtzoff, Federal Practice & Procedure §§1323, 1329 (Wright ed. 1958). In that approach the presence of 60 (b) (3) in the Rules lends considerable strength to the view that there is little real basis for the distinction between extrinsic and intrinsic fraud[34] and in matters of such immediate importance to the administration of justice and the operation of the judicial mechanism, the conduct is to be tested by what it really is, what its effect must have been,

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34. See 3 Barron & Holtzoff, Federal Practice & Procedure §§ 1326, 1331 (Wright ed. 1958), discussing also the opinion by Judge [now Justice] Brennan in Shammas v. Shammas, 1952, 9 N.J. 321, 329-330, 88 A.2d 204, 208.

and what must be done to eradicate it.[35] Certainly that was the approach in *Hazel-Atlas Glass Co.* v. *Hartford-Empire Co.*, 1944, 322 U. S. 238, 64 S. Ct. 997, 88 L. Ed. 1250.

VIII.

On the question whether this calls for or even justifies equitable relief, we are of the view that the showing thus far is adequate for (a) this Court to grant leave to the District Court, (b) the District Court to undertake an appropriate hearing and (c) determine what relief, if any, is available or warranted. In so doing, we think this showing invokes 60 (b) (6).[36] While the circumstances reflected by all of these papers bear many of the earmarks of a mere plea for reopening for newly discovered evidence under (2) or fraud under (3), it is something more. Cf. *United States* v. *Karahalias*, 2 Cir., 1953, 205 F. 2d 331, on rehearing at 334.

When the July-November 1959 applications for stay, recall or modification of the mandate were made to the 6th

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35. Section 126, Restatement, Judgments, itemizing equitable principles for relief states: "(2) Although a judgment is erroneous and inequitable, equitable relief will not be granted to a party thereto on the sole ground that * * * (b) the judgment was obtained by false or perjured testimony, production of false documents, or a conspiracy between the successful party and the witnesses * * *." But the 1948 supplement to the Restatement points out: "Recent decisions make it doubtful whether the Rule stated in subsection (2), Clause (b), would apply to the case of a judgment obtained by perjured testimony or the production of false documents if the perjured testimony or false documents had been knowingly procured by the successful party or his attorney." The explanatory notes state as the "Reason for the Change: the change is called for by the decisions in Hazel Atlas Co. v. Hartford-Empire Co., 1944, 322 U.S. 238, 64 S. Ct. 997, 88 L. Ed. 1250, and Sutter v. Esterly, 1945, 354 Mo. 282, 189 S.W.2d 284, 162 ALR 437. * * *."

36. See Klapprott v. United States, 1949, 335 U.S. 601, 614-15, 69 S. Ct. 384, 93 L. Ed. 266; 3 Barron & Holtzoff, Federal Practice & Procedure § 1330 (Wright ed. 1958).

Circuit, the Patentee, through its chief affiant Williamson, took the position that the brochure was not published "until long after" the 1948 "Road Show." More important, in response to the second application of August 26 in which the Infringer relied on Williamson's pretrial deposition testimony (that he really did not know the date), the Patentee by its answering memoranda asserted in trenchant terms that this was quoting Williamson out of context. The obvious implication was that the earlier affidavit continued as the truth. In the light of developments in the trial and judgment of the District Court in the Minnesota case, this was quite different from a litigant taking full advantage of a favorable fact finding inferred from arguably contradictory evidence. This was an effort, presumably successful, in an affirmative way to convince the 6th Circuit that the truth on this issue, not previously passed on by the Ohio District Court, was contrary to that asserted by the Infringer. More than that, this undertaking was pressed under circumstances which now raise doubt that such a position could fairly be maintained. From the viewpoint of the 6th Circuit, the papers may well have been treated as merely raising a *present* factual dispute as to *when* the brochure was published. That Court was certainly led into taking such a view by the responses made by the Patentee. Had the truth (as it now seems to be established if not acknowledged) of the July 1948 publication been made known, that Court might have taken a closer look at the substantive significance of the brochure alone or in connection with the display of the machinery.

Other factors bear heavily. One is time. Unlike so many equitable attacks, this began before any of the litigation anywhere was completed. The Ohio case was nowhere nearly over. The 6th Circuit's affirmance of the appealable decree of validity still left open the accounting which was not concluded until Judge Jones "final" final judgment

of October 17, 1961. Likewise, when these same matters were asserted in the Texas court in July 1959 and again on December 10, 1959, that case was far from finished. Long before the Patentee was awarded a judgment for $52,000 (now increased twofold plus), the Texas court was told what has now become manifest through the Minnesota decision that the prior publication of the brochure would make the whole patent invalid and, if judicially sustained, the accounting proceedings entirely superfluous.

Another factor, perhaps of even greater importance, is the nature of this litigation. The issue is the validity of a patent. The public interest in a governmentally bestowed monopoly is of transcendent importance. This led us to an extraordinary action fifteen years ago when, in response to a petition for rehearing after the announcement of our earlier opinion, we suspended our mandate and referred back to the District Court a part of the case for further evidence and findings. *Zachos* v. *Sherman-Williams Co.*, 5 Cir., 1948, 166 F. 2d 79, and after recertification, 177 F. 2d 762. There we pointed out "A patent is a monopoly granted by the public and is of public interest, and ought to exist against all or none." This may be of unique significance here for the papers show that the Minnesota plaintiffs are Texas concerns, and another infringement suit brought by the Patentee remains untried in San Antonio. Granted that the concept of a "case or controversy" between specific litigants allows for the possibility of diverse results as to the same patent, and that with the autonomy of each of the eleven Circuits, a similar result may occur nationwide,[37] the result is something less

37. See, e.g., Expanded Metal Co. v. Bradford, 1909, 214 U.S. 366, 29 S. Ct. 652, 53 L. Ed. 1034; Abercrombie & Fitch v. Baldwin, 1917, 245 U.S. 198, 38 S. Ct. 104, 62 L. Ed. 240; Diamond Rubber Co. v. Consolidated Rubber Fire Co., 1911, 220 U.S. 428, 31 S. Ct. 444, 55 L. Ed. 527.

than satisfactory. Another distinguishing element would make such a result in this case more than ordinarily unsatisfactory. If the claim of prior publication is sustained as it was in the Minnesota case, there is a basic statutory infirmity. It is not, therefore, the more routine case in which validity or invalidity turns on intricate evidentiary questions of prior art, anticipation, lack of invention, novelty, or the like.

Another significant factor, related in a way to that of timing, is that so far no rights of intervening third parties have been affected by the present judgment. The only parties affected are the Patentee and the Infringer. The injunction has kept the Infringer from further infringing, and the main appeal here concerns only the question of damages. While this award of damages sounds in the past, rather than the future, no judgment has yet been paid, and in practical effect we are dealing with the prospective application of the judgment, not the unscrambling of the past. Relief may be available for this. Cf. F. R. Civ. P. 60 (b) (5); Restatement, Judgments §125; 3 Barron & Holtzoff, Federal Practice & Procedure §1328.1. (Wright ed. 1958).

The policy of finality is, and should be, strong. But in the face of these unusual factors, we think that equitable principles encompassed within 60 (b) (6) justify further inquiry.

IX.

While we conclude a hearing should be had, we do not by any means suggest that the present equities are all in favor of the Infringer. After years and years of litigation, the Patentee has as yet to realize the fruits of the judgment which, as modified, we affirm. In remanding the case to permit hearing and determination of this limited

matter under 60 (b), we do not think that enforcement of the judgment should be stayed. By its provision that the Court may relieve a party "on motion and upon such terms as are just," and the provision that such a motion "does not affect the finality of a judgment or suspend its operation," Rule 60 (b) envisages that the Court has a wide discretion. Since the Infringer's briefs on the main appeal indicate that the issuance of the permanent injunction has not had a significant effect upon its manufacturing and sales operations, and the matter now remaining is a money judgment, we do not think a stay is required pending final determination of the 60 (b) hearing.[38] The Infringer is, of course, entitled to protection. But it will have sufficient protection by the conditions which we hereby impose. These conditions are that the Patentee, by obtaining satisfaction of the money judgment (in whole or part) by payment or execution, or both, expressly recognizes that it is subject to the orders of the District Court in Texas to effect such restitution as may be required by the decrees or orders in the 60 (b) proceeding. See Restatement, Judgment §§44, 125, Comment *e*. Such conditions are not imposed nor intended as a restriction, in any degree, of the right of either one or both parties to appeal from any such orders. The purpose, rather, is to make certain that since the Patentee is not to be further delayed in the enjoyment of its money judgment, the Infringer, on the other hand, is to have the effective advantage of any 60 (b) orders and restitution occasioned by them without the necessity of commencing yet another suit in another district in another circuit.

We should also emphasize that nothing said or unsaid, expressed or implied, is either a holding or even an intima-

38. Establishing this broad guide line, we do not mean to foreclose such protective orders as the Court in its considered discretion deems reasonably required to meet subsequent, extraordinary developments.

tion of the decision to be reached by the District Court or this Court as to the limited matters remanded for further hearing. The facts finally proved may show there is no basis for equitable relief. That question, as well as all others, including the intrinsic question of the time of the publication and its substantive legal significance, if any, are for the District Court in the first instance, unaffected by what we have said in appraising the sufficiency of them as a showing or by what the Minnesota Court has done in a case involving different parties. By virtue of our inter-circuit federal federalism, these parties to the Texas litigation are entitled to the independent judgment of the Texas District Court and review by this Court. It is far too early to foretell whether, on the merits, the Texas District Court or this Court would or would not agree with the Minnesota Court, or now, the 8th Circuit.

AFFIRMED AS MODIFIED ON THE MAIN APPEAL.

REVERSED AND REMANDED ON THE CROSS APPEAL.

CAMERON, Circuit Judge, concurs in the result.

No. 13,500

UNITED STATES COURT OF APPEALS
SIXTH CIRCUIT

GIBSON-STEWART COMPANY, INC.,
Appellant,

v.

WM. BROS BOILER AND MANUFACTURING COMPANY,
Appellee.

Order

Before ALLEN and MARTIN, Circuit Judges; GOURLEY, District Judge.

Appellant's motion to modify the mandate in this case is denied;

The motion of appellant for further stay of the mandate pending the court's action upon the motion to modify is also denied.

IT IS SO ORDERED

Enter

/s/ John D. Martin
United States Circuit Judge

(Filed July 30, 1959)

No. 13,500

UNITED STATES COURT OF APPEALS
SIXTH CIRCUIT

GIBSON-STEWART COMPANY, INC.,
Appellant,

v.

WM. BROS. BOILER AND MANUFACTURING COMPANY,
Appellee.

Appellant's petition to recall and modify mandate

Decided.....

Before MARTIN, Chief Judge; ALLEN, Circuit Judge; GOURLEY, District Judge.

PER CURIAM. This is a petition by appellant to modify the mandate of this court in the above proceeding based upon a claim of recently discovered evidence and appellee's suspect oath and affidavit.

It is claimed that appellant has obtained new and corrobative evidence of a printed advertisement and offer for sale of Bros 50 Ton Compactor, more than a year prior to filing of the application from which the patent in suit issued, being violative of the patent application oath which in turn renders suspect the application oath signed by the patentee.

In view of the availability of the claimed material in earlier proceedings, and our judgment that the additional affidavits fall short of sufficiency to justify review, appellant's motion for recall and modification of the mandate in this case is refused.

/s/ Wallace S. Gourley

(Filed October 1, 1959)

No. 13,500

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

GIBSON-STEWART COMPANY, INC.,
Appellant,

v.

WM. BROS BOILER AND MANUFACTURING COMPANY (Now by change of name BROS, INCORPORATED),
Appellee.

Order

Before Allen and Martin, Circuit Judges; Gourley, District Judge.

Appellant's "request for reconsideration" of the Order of this Court denying recall and modification of its mandate in this case, entered October 1, 1959, is found to be without merit.

The request is denied in accordance with Judge Gourley's Order of October 1, 1959 and it is hereby ordered that the mandate of this Court be complied with forthwith.

/s/ John D. Martin
U. S. Circuit Judge

(Filed November 13, 1959)

IN THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO EASTERN DIVISION

WM. BROS BOILER AND MANUFACTURING COMPANY, *Plaintiff*,

v.

GIBSON-STEWART CO., *Defendant*.

Filed 11-16-59 Civil No. 31,158 Memorandum on Request of Defendant's Attorney, of October 8, 1959, for Further Delay in Accounting.

JONES, J.:

Upon final action taken by the Court of Appeals, on November 13, 1959, in respect of defendant's "Request for Reconsideration," there is nothing further for this court to do except carry out the mandate of the Court of Appeals as is ordered by Judge Martin in his order of November 13th, as above.

The matters urged in the defendant's request of October 8th here, were presented to the Court of Appeals and I can find neither basis nor power for this court to review what the Court of Appeals already has concluded.

Rule 60 hardly is appropriate where the reviewing court has denied the same relief as is sought by the request here; nor do the defendant's unusual request, and grounds for delay, justify further postponement of the accounting.

Defendant's request for hearing in this court must be denied and an order may be entered appointing Justin W. Macklin, Special Master, with instructions to proceed at once with the accounting.

/s/ Jones
United States District Judge

November 16, 1959.

UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

No. 17,169.

Bros Incorporated, Appellant, vs. Browning Manufacturing Co. and Shovel Supply Co., Inc., Appellees.	Appeal from the United States District Court for the District of Minnesota.

[May 27, 1963.]

Before SANBORN and BLACKMUN, Circuit Judges, and STEPHENSON, District Judge.

SANBORN, Circuit Judge.

This is an appeal from a judgment for the plaintiffs. Texas corporations, (appellees) in an action brought by them in June, 1959, against Bros Incorporated, a Minnesota corporation, (appellant) (Bros) to secure a declaratory judgment that its United States Patent No. 2,610,557 for a "Pneumatic Roller Compactor," issued to C. W. Bros, et al., September 16, 1952, on an application filed November 17, 1949, was invalid. In their complaint the plaintiffs alleged that they had been notified by the defendant that the pneumatic roller compactors made by the plaintiffs infringed the patent in suit. They alleged that the patent was invalid for several reasons. The one with which we are concerned is based on 35 U.S.C. § 102, which provides in part:

"A person shall be entitled to a patent unless—

* * * * * * *

"(b) the invention was patented or described in a printed publication in this or a foreign country * * * more than one year prior to the date of the application for patent in the United States * * *."

The complaint alleged that in a printed pamphlet or advertising folder, entitled "50 Ton Compactor With Oscillating Wheels," which had been prepared and publicly distributed by the defendant at the "Road Show of the American Road Builders' Association held in Chicago, Illinois, from July 16, through July 24, 1948," the claimed invention was fully described and illustrated. This the defendant in its answer denied. By a counterclaim, it asserted that the plaintiffs were infringers, and asked for an injunction and an accounting. The plaintiffs joined issue on the counterclaim.

The case was tried to the District Court after it had denied a motion of the plaintiffs for a summary judgment. The trial judge filed a comprehensive Memorandum Decision and detailed Findings of Fact and Conclusions of Law. He stated that he was in full accord with the views expressed by the United States Courts of Appeals for the Fifth and Sixth Circuits in sustaining the patent as to the patentable novelty of the claimed invention. See *Bros, Incorporated* v. *W. E. Grace Manufacturing Co.*, 5 Cir., 261 F.2d 428, and *Gibson-Stewart Company, Inc.* v. *Wm. Bros Boiler and Manufacturing Company*, 6 Cir., 264 F. 2d 776, certiorari denied 360 U.S. 929. He determined, however, that the publication of the description of the Bros invention in the pamphlet distributed at the Chicago Road Show rendered the patent invalid.

Based upon the Findings of Fact and Conclusions of Law, the trial court entered judgment for the plaintiffs, determining:

> "That each and every claim of United States Letters Patent No. 2,610,557, issued September 16, 1952, on application filed November 17, 1949, is invalid, because the alleged invention therein was described in a printed publication (Defendant's Exhibit D-4, a pamphlet entitled '50 Ton Compactor with Oscillating Wheels') which was distributed by defendant at the July 1948 'Road Show' of the American Road Builders Association at Chicago, Illinois, more than one year prior to the filing of the application for said patent on November 17, 1949."

In its Reply Brief, Bros says:

> "Stated in its simplest form the sole question presented to this Court for decision is whether or not the Bros pamphlet, Defendant's Exhibit D-4, describes the invention defined by the claims of the patent in suit, so as to render the patent invalid under the provisions of 35 U.S. Code, No. 102(b)."

No question is raised with respect to the finding that more than one year before the patent was applied for, there had been a distribution of the Bros printed pamphlet (Defendant's Exhibit D-4), descriptive of its "compactor", at the July 1948 Road Show in Chicago. All that Bros now contends is that the description of the invention in its Road Show pamphlet was insufficient to invalidate its patent, under 35 U.S.C. § 102(b).

The Findings of the trial court relative to the pamphlet in suit read as follows:

> "Exhibit D-4 is a one-piece four-page black and white pamphlet. The cover page is entitled '50 Ton Compactor with Oscillating Wheels' with a Bros insignia reading 'Bros'. At the bottom there is printed 'Wm. Bros Boiler & Mfg. Co., Minneapolis, Minnesota.' The inside pages consist of four photographs of the machine showing it attached to a tractor. The photographs are taken from various angles. One of

the photographs shows the oscillating effect of the wheels as the machine moves over uneven ground. The printed material on the inside pages consists of the following:

" 'FULL WIDTH COVERAGE PREVENTS HAULING EQUIPMENT FROM "BOGGING DOWN"

" 'Specifications

" 'Empty shipping weight 24,000 lbs.
Maximum loaded weight, 100,000 lbs.
Main Tire Sizes (4), 18:00 x 24-24 ply
Maximum Tire Air Pressure for 100,000 lb. load, 70 lbs. per sq. in.
Minimum Tire Air Pressure for empty roller, 50 lbs. per sq. in.
Tire Size (when front dual wheel dolly used) (2), 12:00 x 20-14 ply
Body capacity, 640 cu. feet
Tongue Neck Capacity, 25 cu. ft. or 187 gal.
Maximum travel speed with 100,000 lb. gross load, 5 mi. per hr.
Rolling width, 8' 10"
Overall body and tongue length, 26' 6"
Overall body width (less outside tires), 8 feet
Overall height on tires, 7' 9½"

" 'THE NEW BROS GIANT SIZE PNEUMATIC TIRED 50 TON ROLLER

" '(Model No. 6 with Oscillating Wheels)

" 'A new step towards better compaction to speed up the job. Especially designed for airport, embankment and heavy fill work. Flexible loads starting at 24,000 pounds empty to 100,000 pounds loaded. Especially designed to prevent hauling equipment from "bogging down" and keeping wagons and scrapers on their regular jobs. Gives an 8' 10" roller coverage and easily pulled when used in combination with a

LaPlant-Choate tractor Model T-300 or any large crawler tractor. Also comes equipped with dual front wheel dolly for towing behind tractors. Oscillating wheels permit proper angle coverage.

" 'Price $12,500.00 f.o.b. Minneapolis, Minn.'

"On the fourth or back page of the pamphlet are two white on black drawings of rollers. Each of the drawings shows side and top views of the machine and on one drawing the machine has a 'two-wheel dolly' attached to it and on the other a 'LaPlant-Choate Tractor' is attached.

"The published pamphlet, defendant's Exhibit D-4, taught to the industry the essential elements and features of the patent in suit and the impelling weight of the evidence amply supports the finding, and the Court does find, that the essence of the invention, that is, the inventive concept which is the basis for the claims of this patent, was fully disclosed in this pamphlet and enabled one skilled in the art to build and produce the roller compactor described in this patent."

The trial court based its judgment for the plaintiffs upon 35 U.S.C. § 102(b) because there was competent evidence which convinced the court that the invention disclosed by the patent was described in the pamphlet with sufficient particularity to enable one skilled in the art of constructing such machinery to reproduce the invention without having to resort to the patent.

This same question as to the sufficiency, under this same statute, of the description of an invention in a foreign publication ante-dating by more than one year the application for a patent, was raised and decided adversely to the owner of the patent in *Collins* v. *Owens,* D.C. N.D. Iowa, 199 F.Supp. 61, affirmed, 8 Cir., 310 F.2d 884 (1962).

If, in the instant case, there was a substantial evidentiary basis for the trial court's determination that the description of the invention in the defendant's Road Show pamphlet was, alone, sufficient to enable one skilled in the art to produce the invention, the judgment must be affirmed. *Collins* v. *Owens,* supra, page 887 of 310 F. 2d. We said in that case:

> "The test for determining the adequacy of the description of an invention in a foreign publication is, as the trial court recognized, that 'the knowledge "derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use," * * *.'"

See, also, *Midland Flour Milling Co.* v. *Bobbitt,* 8 Cir., 70 F.2d 416, 418. The same test is, of course, applicable to the description of an invention in a domestic publication.

Bros contends that in the *Collins* case the issues were not the same as in the instant case and that the *Collins* case arose out of a different situation. We perceive no controlling distinction. In each case the key issue was the adequacy of the published description of the invention. In this case, as in *Collins,* the issue was, under the evidence, clearly one of fact to be determined by the trial court, and is not a question of law for this Court to decide.

It is argued on behalf of Bros that the trial court misinterpreted § 102(b), which, it is contended, when read in connection with § 103,[1] makes any description of an in-

1. § 103, Title 35 U.S.C.:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

vention in a printed publication inadequate to invalidate a patent unless the invention is "identically disclosed or described."

The legislative history of the 1952 revision of the Patent laws (Title 35 U.S.C., 1946 Ed.) refutes the contention that § 103 was intended to modify or affect in any way § 102(b). The "Revision Notes", attached to and made a part of the Reports of the Judiciary Committees of Congress, relating to the revision, appear on pages 2403-2428, Vol. 2, U. S. Code Congressional and Administrative News, 82nd Congress, Second Session, 1952. The Report of the Judiciary Committee of the Senate, with the "Revision Notes" attached, appears on pages 2394-2428. The notes on pages 2410-2411 read as follows:

"SECTION 102—SECTION REVISED

"Paragraphs (a), (b) and (c) are based on 35 U.S.C., 1946 ed., § 31 * * *.

"No change is made in these paragraphs other than that due to division into lettered paragraphs.

* * *

* * * * * * * *

"SECTION 103—NEW SECTION

"There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

> "The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius."

As this Court, not infrequently in the past, has said:

> "* * * [T]he plain, obvious and rational meaning of a statute is always to be preferred to any curious, narrow, hidden sense that nothing but the exigency of a hard case and the ingenuity and study of an acute and powerful intelect would discover."

Lynch v. *Alworth-Stephens Co.*, 8 Cir., 294 F. 190, 194, and cases cited.

The suggestion that the trial court failed to give appropriate weight to the refusal of the courts of the Fifth and Sixth Circuits to re-open the cases sustaining the validity of the patent, so as to enable the defendants in those cases to inject the issue of invalidity because of the Road Show pamphlet, is without merit. The plaintiffs here were not parties to those cases. The motions to re-open were made after judgment, and were addressed to the discretion of the courts which had decided the cases. The plaintiffs were free to bring this action in the District of Minnesota, and the trial court had the duty and responsibility of deciding for itself the issues presented.

The decision of the District Court, based as it is upon an issue of fact, is conclusive upon us. "This Court, upon review, will not retry issues of fact or substitute its judgment with respect to such issues for that of the trial court." *Cleo Syrup Corporation* v. *Coca-Cola Co.*, 8 Cir., 139 F.2d 416, 417, certiorari denied 321 U.S. 781.

Unfortunately, the appellant and the appellees did not cooperate in the preparation of a short and concise

printed record on appeal. The appellees considered the appellant's printed record inadequate and filed a printed supplement. They ask that its cost be taxed against the appellant, which they assert had refused to cooperate. This the appellant denies. We shall not attempt to resolve this controversy. The appellees' request is denied.

The judgment appealed from is affirmed.

A true copy.

Attest:

Clerk, U. S. Court of Appeals, Eighth Circuit.

UNITED STATES DISTRICT COURT, DISTRICT OF MINNESOTA, FOURTH DIVISION.

BROWNING MANUFACTURING COMPANY, AND SHOVEL SUPPLY COMPANY,
Plaintiffs,

vs.

BROS, INCORPORATED,
Defendant.

4-59 Civ. 92.

Memorandum Decision

This cause comes before the Court on a complaint filed by plaintiffs, Browning Manufacturing Company, a Texas corporation, hereinafter referred to as "Browning", and Shovel Supply Company, Inc., a Texas corporation, hereinafter referred to as "Shovel Supply" seeking a declaratory judgment against the defendant, Bros, Incorporated, a Minnesota corporation. The plaintiffs had been served

with notices of infringement and they bring this action seeking to have the patent in suit, E. W. Bros, et al., Pneumatic Roller Compactor, No. 2,610,557 filed November 17, 1949, granted September 16, 1952, declared invalid and noninfringed. Bros, Inc., has, by way of answer and counterclaim, denied plaintiffs' allegations regarding invalidity and has asserted a claim for an injunction and notices for infringement.

* * * *

Basically, the patent in suit describes a box or cart-like structure mounted over a series of four pneumatic-tired wheels which are located in a recess substantially midway of the structure. The wheels are mounted on axles which allow oscillation. This provides equal weight distribution even though the machine is proceeding over uneven terrain. The machine is designed to be pulled over an area upon which a project such as a highway or an airfield is to be constructed. The heavy weight of the machine compresses or compacts the soil which forms the base of such project. According to the patent, the machine is intended to be built in sizes ranging from 35 to 200 tons. Only a small portion of such weight is due to the structure itself, the rest is due to the ballast, wet sand or heavy metals with which the machine is loaded.

Even though the present suit was brought by Browning and Shovel Supply, it is one of a series of cases by which Bros seeks to enforce its patent against alleged infringer. An earlier suit has been tried in Cleveland, Ohio, against the Gibson-Stewart Co., Inc., a distributor of the W. E. Grace Manufacturing Co., and alleged infringer. The issue before that Court was the validity of the Bros patent and infringement if valid was admitted. The Court held that the patent was valid 116 U.S.P.Q. 138, and was affirmed by the Sixth Circuit, 264 F.2d 776

(1959), cert. denied, 360 U.S. 929. A second suit was commenced in Texas against the W. E. Grace Co., et al., and the Court granted Bros's motion for summary judgment on the ground that Grace was the real party and had actually defended the Cleveland suit and that decision was res judicata against it. 158 F.Supp. 786, aff'd 261 F.2d 428 (5 Cir., 1960).

Plaintiffs raise the following grounds for having the patent declared invalid: (a) That the roller was unpatentable because the device is devoid of any patentable novelty; (b) that the patent was described in a printed publication more than one year prior to the application for the patent; (c) that the roller was on sale and in public use more than one year prior to the application for the patent; (d) that the patent is invalid because new matter was added to the patent application long after its filing date, and (e) that there was an abandonment by the patentees of the invention.

It does not seem necessary to indulge in a lengthy discussion as to the challenge which is made to the patentable novelty of the roller. This Court is fully in accord with the views expressed by the Fifth and Sixth Circuits in that regard. The patent is one which may be termed a "combination patent"; that is, it consists of a combination of elements which have been known to the industry prior to their incorporation into the device described in the patent. It has not been argued, and it cannot be, that any of the elements of the patent are novel or unique. The unitary body, pneumatic-tired wheels, oscillating or rocking beam wheels, recess, well, etc., had all been in use in various machines in the industry prior to their adoption in this patent. But the language of the Court in the Sixth Circuit seems entirely apposite to the evidence here:

"* * * In the light of the record we think it would be an all too sweeping and incorrect generalization to say that the subject matter of the patent in suit would be obvious to those schooled in the art at the time the invention was disclosed. We think that the objective was attained by the claims of the patent to provide a pneumatic-tired roller, so constructed and of such weight as to produce compaction of sufficient magnitude to bring about deeper penetration and more intense densification than had been accomplished before, without sacrifice of rigidity of body or maneuverability." 264 F.2d 776, 779-780.

The history of the attempts on the part of the industry to accomplish heavy compaction prior to the patent in suit is aptly illustrated by the article in the publications "Technical Bulletin No. 109, January, 1946, American Road Builders Association," "The Use of Heavy Equipment for Obtaining Maximum Compaction of Soils" by O. J. Porter (Defendant's Exhibit O), and by the testimony of Archie O. Williamson, one of the patentees. The roller covered by the patent has had outstanding commercial success and clearly has filled a need in the industry with regard to heavy compaction. The language of Judge Learned Hand is Reiner v. I. Leon Co., Inc., 128 U.S.P.Q. 25, 27 (1960, 2 Cir.), is applicable here.

"We are of course acutely aware of the constant reminders in the books that the sale of a patented device is not alone a measure of its invention and we accept that conclusion. Nevertheless, great commercial success, when properly scrutinized, may be a telling circumstance. It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination': that is to say, it consists of former elements in a new assemblage. All of the constituents may be old, if their new concourse would not 'have been

obvious at the time the invention was made to a person having ordinary skill in the art' (§ 103, Title 35)."

None of the prior art references cited by the plaintiffs had incorporated therein all of the elements of the present patent. The alleged anticipation of Grace, Browning and Porter were considered by the Sixth Circuit, and were held not to anticipate the combination patent in suit.

Although the Court, in light of the evidence, is without any misgivings as to the validity of the patent, in absence of the defense of prior publication by the defendant, that aspect of the lawsuit presents the question as to whether or not the defendant is confronted with a statutory bar to the finding of validity. Section 102(b), Title 35, U.S.C., provides that a person shall be entitled to a patent unless

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, * * *."

The background of the publication, Exhibit D-4, is as follows: In July of 1948, the American Road Builders Association conducted a so-called "Road Show" in Chicago, Illinois. The purpose of the show was to exhibit the Association's road equipment; that is, the members of the Association displayed their road machinery to the trade and to the public. Bros exhibited the roller described in the patent in issue here. Attached to the sides of the roller were blueprint drawings of the machine. (The Court heretofore has held that these drawings did not constitute a printed publication within the meaning of the statute.) The exhibit of the roller undoubtedly was visited by a substantial number of people who attended the show. There is persuasive evidence by several witnesses who attended the show that at the site of the exhibition of the

roller a printed pamphlet was freely distributed by Bros's representatives to the patrons of the show. The testimony adduced by the defendant in this regard is to the effect that its officials do not recall that the pamphlet was distributed at the show and question the reliability of the evidence offered by the plaintiffs as to its distribution primarily because defendant urges that the circumstances would indicate that it had not had sufficient time to have the pamphlet printed before the opening of the show; that is, the photographs shown in the pamphlet were taken at the LaPlant-Choate Company in Iowa during the last week in June, 1948, about two weeks before the opening of the show, and there the roller was being prepared for shipment to the show when the pictures were taken. Hence, it is urged that there was not sufficient time between the taking of the pictures and the exhibition of the roller to have the pictures incorporated in the printed pamphlet which has been referred to here as Exhibit D-4. However, there is evidence that the very nature of the printed pamphlet would indicate that it was a hurry-up job and could have been printed in a very short period of time.

Defendant makes reference to the fact that after the denial of the petition for certiorari by the Supreme Court in the Sixth Circuit litigation over the validity of this patent, the defendant in that suit moved the Sixth Circuit to modify its mandate so as to present consideration of the effect of the distribution of the pamphlet at the Chicago Road Show. Affidavits were presented regarding the distribution of the pamphlet. However, the Sixth Circuit rejected the showing as "falling short of sufficiency" to justify a review of its holding. Apparently the distribution of the pamphlet was not before the trial Court. Likewise, defendant refers to an attempt of the defendant in the litigation in the Fifth Circuit to obtain

a hearing on the issue of the publication of this pamphlet. This occurred before the trial Court after it had granted summary judgment and an order for an accounting. However, the proceedings in the Fifth and Sixth Circuits on this issue are of little, if any, weight in light of the complete trial of this matter before this Court. This Court now has heard the testimony of several witnesses who attended the show and who personally received copies of the pamphlet. The extent of its distribution has been clearly established. Also the Court has heard defendant's testimony as to its lack of knowledge of the pamphlet distribution at the Road Show and its arguments which question the possibility or probability of its printing and distribution in July, 1948. The entire record impels a finding that the pamphlet was distributed to a substantial number of people during the show in July, 1948, which was over a year prior to the application for the patent herein.

Exhibit D-4 is a one-piece four-page black and white pamphlet. The cover page is entitled "50 Ton Compactor with Oscillating Wheels" with a Bros insignia reading "Bros". At the bottom there is printed "Wm. Bros Boiler & Mfg. Co., Minneapolis, Minnesota." The inside pages consist of four photographs of the machine showing it attached to a trailer. The photographs are taken from various angles. One of the photographs shows the oscillating effect of the wheels as the machine moves over uneven ground. The printed material on the inside pages consists of the following:

"Full Width Coverage Prevents Hauling Equipment From 'Bogging Down'.

"Specifications.

"Empty shipping weight—24,000 lbs.
Maximum loaded weight—100,000 lbs.
Main Tire Sizes (4)—18:00x24-24 ply

Maximum Tire Air Pressure for 100,000 lb. load—70 lbs. per sq. in.

Minimum Tire Air Pressure for empty roller—50 lbs. per sq. in.

Tire Size (when front dual wheel dolly used) (2)—12:00x20-14 ply

Body capacity—640 Cu. feet

Tongue Neck Capacity—25 cu. ft. or 187 gal.

Maximum travel speed with 100,000 lb. gross load—5 mi. per hr.

Rolling width—8'10"

Overall body and tongue length—26'6"

Overall body width (less outside tires)—8 feet

Overall height on tires—7'9½"

"The New Bros Giant Size Pneumatic Tired 50 Ton Roller.

(Model No. 6 with Oscillating Wheels.)

"A new step towards better compaction to speed up the job. Especially designed for airport, embankment, and heavy fill work. Flexible loads starting at 24,000 pounds empty to 100,000 pounds loaded. Especially designed to prevent hauling equipment from 'bogging down' and keeping wagons and scrapers on their regular jobs. Gives an 8'10" roller coverage and easily pulled when used in combination with a LaPlant-Choate tractor Model T-300 or any large crawler tractor. Also comes equipped with dual front wheel dolly for towing behind tractors. Oscillating wheels permit proper angle coverage.

"Price $12,500.00 f.o.b. Minneapolis, Minn."

On the fourth or back page of the pamphlet are two white on black drawings of rollers. Each of the drawings shows side and top views of the machine and on one draw-

ing the machine has a "two-wheel dolly" attached to it and on the other a "LaPlant-Choate Tractor" is attached. In considering the disclosure made by the pamphlet, it would seem that the defendant necessarily intended that it should be interpreted and construed in light of the exhibition of the machine which was before the public and which admittedly conforms to the teachings of the patent. But it seems evident that this publication itself taught the essential elements of the patent to the industry without reference to the exhibited machine, and there is cogent testimony that one skilled in the art "familiar with the publication and with the prior art generally would have had no great difficulty in producing a similar device, despite the fact that exact drawings and specifications are lacking." Trice Products Corp. v. Delman Corporation, 180 F.2d 529, 533 (1950, 8 Cir.); Application of Pappas, 214 F.2d 172. Defendant strongly urges, however, that the pamphlet is not effective as a prior publication because it does not completely disclose all of the elements of the patent claims. It is of some significance, however, that during the presentation of the patent, this very pamphlet was referred to by the patentees as a catalog disclosure of the invention. Defendant has listed some eleven features which it contends the pamphlet does not disclose. The list includes such items as the draft beam running the length of the machine, the bearing beams at the lower ends of the recess, the rocker beams support of the recess walls, etc. But all of the items referred to by defendant relate primarily to the bracing of the machine against the stresses to which it would be subjected while in actual operation. It seems apparent that any competent engineer in the industry with the drawings and photographs disclosed in this pamphlet would know the stresses and strains to which the machine would be subjected and would brace the machine

accordingly. In other words, the bracing of the machine would be merely the application of ordinary mechanical skill. The essence of the invention, that is, the inventive concept which is the basis for the claims of this patent was fully disclosed by this pamphlet. The denial to an inventor of the fruits of his contribution to the art by reason of the publication of his own catalog more than one year prior to the application for a patent may seem harsh and unyielding, and an issued patent should not be lightly annulled. But the clear language of the statute permits no other finding in light of the impelling evidence. The Court concludes, therefore, that the patent must be declared invalid because it was described in a printed publication in this country more than a year prior to the date of the application for patent in the United States.

* * * *

In view of the finding as to the invalidity of the patent by reason of the printed publication issued by the defendant more than one year prior to the date of the application for the patent herein, it does not seem necessary to discuss the question of infringement.

Findings of fact and conclusions of law consistent herewith may be presented by plaintiffs on ten days' notice. Exceptions are reserved.

Dated this 21st day of February, 1962.

By the Court:

GUNNAR H. NORDBYE,
Judge.

UNITED STATES DISTRICT COURT, DISTRICT OF MINNESOTA, FOURTH DIVISION.

BROWNING MANUFACTURING COMPANY AND SHOVEL SUPPLY COMPANY,
Plaintiffs,

vs.

BROS, INCORPORATED,
Defendant.

4-59 Civ. 92.

Order

(Filed May 9, 1962.)

This matter came before the Court on defendant's motion under Rule 52(b), Federal Rules of Civil Procedure, to amend the Findings of Fact and Conclusions of Law herein dated March 20, 1962. Plaintiffs have proposed an additional Finding of Fact No. 23.

The Court has given due consideration to defendant's motion and its memorandum in support thereof, together with the memorandum filed in support of its motion for rehearing.

The defendant contends that the Court proceeded under a misapprehension of law in concluding that Exhibit D-4 was a printed publication in July, 1948, which described the invention within the meaning of Section 102(b), Title 35, United States Code. It may be that defendants' position in that regard in part at least arises because the Court in its findings in paragraph 21 stated that:

> "One skilled in the art and familiar with the publication and with the prior art generally would have no great difficulty in producing a similar device."

Defendant concludes that the Court was laboring under the impression that the pamphlet could be treated as prior art. It is possible that the Court's language, standing alone, may be subject to that interpretation. However, the term "familiar with the publication and with the prior art" was not intended to convey the meaning that the pamphlet should be considered as prior art; rather, that one skilled in the art, with the pamphlet, could produce the 50 ton compactor without any great difficulty.

Moreover, the Court concludes that there may be substance to defendant's position when it urges that the pamphlet should not be construed or interpreted in light of the exhibition of the machine. Consequently, that portion of the Court's Findings may be stricken. In that the Court's language in this paragraph may not clearly indicate the Court's Findings on this issue, it is ordered that Finding No. 21 will be stricken and the following substituted therefor as an amended Finding No. 21:

> "The published pamphlet, defendant's Exhibit D-4, taught to the industry the essential elements and features of the patent in suit and the impelling weight of the evidence amply supports the finding, and the Court does find, that the essence of the invention, that is, the inventive concept which is the basis for the claims of this patent, was fully disclosed in this pamphlet and enabled one skilled in the art to build and produce the roller compactor described in this patent."

With this amendment, there will be no doubt that the Court concludes that the pamphlet taken "by its four corners" describes to one skilled in the art the invention within the purview of Section 102(b), Title 35, United States Code. The memorandum decision of the Court of February 21, 1962, should be construed accordingly.

The Court further concludes, and it is so ordered, that an additional Finding No. 23 proposed by the plaintiffs should be added to the Court's Findings. This Finding reads as follows:

> "Defendant makes reference to the fact that after the denial of the petition for certiorari by the Supreme Court in the Sixth Circuit litigation over the validity of this patent, the defendant in that suit moved the Sixth Circuit to modify its mandate so as to present consideration of the effect of the distribution of the pamphlet at the Chicago Road Show. Affidavits were presented regarding the distribution of the pamphlet. However, the Sixth Circuit rejected the showing as 'falling short of sufficiency' to justify a review of its holding. Apparently the distribution of the pamphlet was not before the trial court. Likewise, defendant refers to an attempt of the defendant in the litigation in the Fifth Circuit to obtain a hearing on the issue of the publication of this pamphlet. This occurred before the trial court after it had granted summary judgment and an order for an accounting. However, the proceedings in the Fifth and Sixth Circuits on this issue are of little if any, weight in light of the complete trial of this matter before this Court. This Court now has heard the testimony of several witnesses who attended the show and who personally received copies of the pamphlet. The extent of its distribution has been clearly established."

It is ordered: That defendant's motion for amended Findings and Conclusions of Law, except as herein indicated, be and the same hereby is in all things denied. An exception is allowed.

Plaintiffs may submit an appropriate form of judgment on the amended Findings of Fact and Conclusions of Law. It is so ordered.

Dated this 9th day of May, 1962.

By the Court:

GUNNAR H. NORDBYE,
Judge.

Counterclaim Proposed by Petitioners to State a Cause for Actionable Fraud Against Respondent As a Supplement to the Answer of Record

And, by way of amendment, the aforesaid Defendants additionally allege, as a basis for Counterclaim, that:

17. On June 23, 1959, the aforesaid Plaintiff, by means of an affidavit of Archie O. Williamson, its Managing Agent and Director, prepared in response to the requirements of an Order by the United States District Court for the District of Minnesota in related Civil Action No. 459 Civ. 92 then pending at Minneapolis, represented that it "did not cause" a certain printed publication "to be prepared and publicly distributed" at a certain Road Show held in Chicago, Illinois, in July of 1948, and that this certain printed publication "was not prepared or distributed" by Plaintiff "until long after said Road Show."

18. The certain printed publication aforesaid was in fact caused by Plaintiff to be prepared prior to July 22, 1948, at Gile Letter Service in Minneapolis, Minnesota, and was in fact caused by Plaintiff to be publicly distributed at the certain Road Show aforesaid; and the means for determining that this was so has always been in Plaintiff's possession.

19. On July 29, 1959, by a further affidavit of the same affiant Williamson, made in response to the requirements of a further Order of Court in the aforesaid Minnesota Civil Action No. 459 Civ. 92, Plaintiff further purported to disclose the names and addresses of all "printers or printing companies now known to have prepared printing material publicly distributed" for it "since January 1, 1948."

20. The aforesaid further affidavit did not disclose the name or address of the aforesaid Gile Letter Service

although Plaintiff, and its aforesaid affiant Williamson, knew at the time that printing material for public distribution had in fact been prepared for Plaintiff by the said Gile Letter Service since January 1, 1948.

21. When the aforesaid affidavit statements were made by Plaintiff a factual determination of whether the certain printed publication aforesaid had been publicly distributed at the certain Road Show aforesaid was of critical significance because it had just been discovered and, although bearing no date, it illustrated and described the subject matter of the patent in suit and could raise a decisive statutory bar rendering the patent invalid if its distribution at said Road Show, or prior to November 17, 1948, could be established.

22. When the first of the aforesaid affidavits was executed on June 23, 1959, the affiant Williamson had no knowledge on which to base the affidavit denial of Plaintiff's public distribution of the certain printed publication aforesaid at the certain Road Show aforesaid, or any reasonable basis even for believing that the certain printed publication aforesaid had not been publicly distributed by Plaintiff "until long after said Road Show."

23. The first aforesaid affidavit executed June 23, 1959, was forcefully urged by Plaintiff as stating the truth in opposition to a contemporaneous attempt by Defendants to reopen additionally related litigation (then pending as Appeal No. 13,500 before the United States Court of Appeals for the Sixth Circuit) on the basis of the certain printed publication aforesaid.

24. In passing on Defendants' reopening attempt, the United States Court of Appeals for the Sixth Circuit was faced with a consideration of whether the attempt was supported by prima facie evidence of a substantial character, and that Court might reasonably have relied on the

apparently solemn assertion by Plaintiff's affiant Williamson that the undated printed publication supporting the reopening attempt had not been published early enough to constitute an invalidating prior publication.

25. The United States Court of Appeals for the Sixth Circuit did in fact deny Defendants' reopening attempt, and a following petition to reopen was denied herein on principles of res judicata previously found applicable to the original case by the United States Court of Appeals for the Fifth Circuit in Appeal No. 17,194.

26. The second aforesaid affidavit executed July 29, 1959, which failed to disclose the name or address of Gile Letter Service as being known by Plaintiff to have prepared printing material for it since January 1, 1948, prevented discovery of the publication date for the certain printed publication aforesaid at a time when such discovery could have had a material bearing on Defendants' reopening attempt in the United States Court of Appeals for the Sixth Circuit, and on the following petition to reopen herein.

27. Because Defendants' reopening attempts were denied, Defendants have been subjected to burdensome accounting proceedings and have remained subject to injunction herein until January 21, 1964, when Defendants were finally able to establish the certain printed publication aforesaid as an invalidating prior publication after being granted permission to attempt doing so by the United States Court of Appeals for the Fifth Circuit in Appeal No. 21,012.

28. While subject to the aforesaid injunction, Defendants were prevented from manufacturing and selling devices previously held herein to infringe the patent in suit, and were thereby prevented from attempting to make substantial sales of such devices that Defendants could reasonably have been expected to make if not so prevented;

namely, the sale of such devices in response to invitations for bids by the United States Corps of Engineers based on specifications that could be responsibly met only with devices such as had previously been held herein to infringe.

29. In the period since the first aforesaid Williamson affidavit of June 23, 1959, was uttered by Plaintiff, Defendants have been prevented as aforesaid from attempting to sell at least ninety-eight (98) devices in response to invitations for bids by the United States Corps of Engineers, and it has already been found during the accounting proceedings herein that the profit from the sale of each such device amounts to at least two thousand dollars ($2,000).

30. Also, in the same period aforesaid Defendants have been forced to incur litigation expenses that have averaged at least ten thousand dollars ($10,000) annually, and were found liable to Plaintiff for patent infringement in an aggregate amount (now vacated) exceeding two hundred thousand dollars ($200,000.).

31. The matters alleged in the foregoing paragraphs 17 through 30 arise out of the transaction or occurrence that is the subject matter of the Complaint herein; these matters form the basis for stating a claim for damages resulting consequently and proximately from Plaintiff's tortious conduct; and the claim for damages thus resulting places a matter in controversy exceeding the sum or value of ten thousand dollars ($10,000), exclusive of costs and interest, and does not require for adjudication the presence of any parties other than those of whom the Court already has jurisdiction; namely, the aforesaid Plaintiff and Defendants who are, respectively, citizens of different states, with all of the aforesaid Defendants residing within the Northern District of Texas.

WHEREFORE, Defendants pray:

1. That, by reason of Plaintiff's concealment in discovery and misrepresentation of the true facts herein, Defendants be awarded consequent and proximate damages in an amount calculated at two thousand dollars ($2,000) for each device that Defendants were prevented from attempting to sell in response to invitations for bids by the United States Corps of Engineers as aforesaid, together with interest from the date such sales were awarded;

2. That, by reason of Plaintiff's aforesaid tortious conduct, Defendants be awarded exemplary damages in an amount commensurate with the patent infringement liability to which Defendants would have been subject if such tortious conduct had not been discovered;

3. That Defendants be awarded litigation expenses at an annual rate of at least ten thousand dollars ($10,000) from the date at which Plaintiff's aforesaid tortious conduct began by utterance of the Williamson affidavit of June 23, 1959, to the date of judgment;

4. That all taxable costs herein be assessed against Plaintiff, and any taxable costs heretofore assessed against Defendants be recovered from Plaintiff; and

5. That Defendants be granted such other or further relief as the Court shall find just.

Office-Supreme Court, U.S.
FILED
FEB 16 1966
JOHN F. DAVIS, CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 915

W. E. GRACE MANUFACTURING COMPANY AND WILLIAM E. GRACE

Petitioners

vs.

BROS INCORPORATED

Respondent

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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FOREWORD

Respondent opposes the present Petition for Writ of Certiorari for the reasons that the background facts stated therein are deceptively incomplete, and because the "*Questions Presented*" as expressed in the petition (p. 3) do not state or reflect issues over which this Court should take jurisdiction to review.

Respondent admits that there is direct conflict between the decisions (1a and 50a) of the Courts of Appeals for the Fifth and Eighth Circuits on "a vital point of substantive patent law," as noted in the Fifth Circuit decision (3a), and on exactly the same basic and critical facts (Pet. pp. 2 and 10).

Respondent also admits that it is requesting rehearing by this Court of its denial of certiorari in the Eighth Circuit case, its Petition for Rehearing having been filed (in No. 255 O. T. 1963) on December 29, 1965.

The foregoing, however, by no means warrants the presumption indulged in by the present petitioners (p. 2) that respondent is "ready for agreement that the present petition should be granted." Quite the contrary. The petition, as here presented, should be dismissed for the simple reason that the aforesaid "vital point of substantive patent law" is *not* whether there "*must*—be a *precise identity* between the publication and the patent claim for 'time-bar' purposes," as stated in the first question presented (p. 3), and which the lower courts have not held to be the case; but rather whether the Fifth Circuit Court of Appeals was right or wrong in holding "as clearly erroneous the decision of the District Judge that the brochure disclosed the invention described in the claims" (16a) because "this critical fact finding was not made in the light of the correct controlling legal principles" (17a).

As for the second or "collateral" question presented by the petition (p. 3) it is entirely irrelevant to any other issue or question that may be found to exist, and is therefore completely out of order, as will presently be pointed out.

Inasmuch as Bros Inc. is the plaintiff-respondent in this case, and is defendant-petitioner in the Eighth Circuit case, it will, to avoid confusion, be sometimes referred to herein as the Patentee, while the corporate and individual defendants-petitioners will be designated the Graces, or the Infringers, as was done in the Fifth Circuit decisions. Petitioners' Appendix pages have been numbered 1a, 2a, etc., while those of the present Appendix are numbered B-1, B-2, etc.

COUNTERSTATEMENT OF THE CASE

The Bros patent (2,610,557) has been litigated in three circuits and has been the subject of no less than eleven reported decisions, the sequential rundown of which is given (2a) in the Fifth Circuit decision of September 14, 1965. Validity was first sustained in the Ohio case;[1] and that decision was affirmed by the Sixth Circuit Court of Appeals in 1959.[2] Following an accounting the Sixth Circuit rendered a decision on that subject in 1963.[3]

As the Graces had openly defended the Ohio case they were sued in Dallas, Texas, and under *res judicata* were held bound by the Sixth Circuit Judgment, that holding being confirmed by the Fifth Circuit Court of Appeals[4] in 1958.

Meanwhile, two other noticed Texas infringers, Browning Mfg. Co. and Shovel Supply Co., joined forces, and not wanting to wait until they would be named defendants in a Fifth or Sixth Circuit Court, filed a declaratory judgment action against the Patentee in Minnesota. After a lengthy trial and extensive briefing the trial judge, the Honorable Gunnar H. Nordbye, rendered a decision (58a) in which he agreed with the Sixth Circuit on all questions of invention, anticipation, etc., going so far as to say that he was "without any misgivings as to the validity of the patent" (62a), except only for the defense of the statutory bar that had been raised under 35 U.S.C. Section 102(b) by reason of the Patentee's own publication, a pamphlet

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[1] *William Bros Boiler & Mfg. Co. v. Gibson-Stewart Co., Inc.*, 116 USPQ 138.

[2] *Gibson-Stewart Co., Inc. v. William Bros Boiler & Mfg. Co.*, 264 F.2d 776, c.d. 360 U.S. 929, 79 S.Ct. 1448, 3 L.Ed.2d 1544.

[3] *Wm. Bros Boiler & Mfg. Co. v. Gibson-Stewart*, 312 F.2d 385.

[4] *Bros Inc. v. W. E. Grace Mfg. Co.*, 261 F.2d 428.

which had been printed and distributed more than one year prior to the filing date of the patent in suit. As to it he concluded (B-1) that:

> "as the invention of the patent was described in such pamphlet, said patent, with respect to each of the four claims therein, is invalid under the provisions of 35 U. S. Code § 102(b)."

The quoted language is important because it pinpoints the only defense that has ever been sustained against the Bros patent, and because it initiated the chain of events that have brought about the present conflict of decisions.

Thus, and within a month after Judge Nordbye's decision (58a) the Graces moved (B-2) to reopen the Texas case:

> "for the purpose of granting a partial new trial devoted to the issue of statutory invalidity of the patent in suit by reason of prior description in a printed publication, contrary to the conditions prescribed by 35 U.S.C. 102(b)."

noting further, that:

> "Judge Nordbye's finding of invalidity was based specifically and solely on the particular issue for which a partial new trial is sought by the present motion."

The Graces' Motion was denied by the Dallas District Court on April 17, 1962, whereupon an appeal was taken to the Fifth Circuit Court of Appeals, the appeal notice (B-3) again precisely stating that it was:

> "for the purpose of granting a partial new trial devoted to the issue of statutory invalidity of the patent in suit by reason of prior description in a printed publication, contrary to the conditions prescribed by 35 U.S.C. 102(b)."

In the Minnesota case, and upon the entering of judgment on June 12, 1962, the Patentee filed its Notice of Appeal and a Statement of Points (B-4) in which it asserted that the District Judge erred:

> 1. in its understanding of the patent claims in suit and in not construing them in the light of the Patent Office proceedings,
>
> 2. in holding that inventive concept of the claims is fully disclosed in the Bros pamphlet, and
>
> 3. in its interpretation of 35 U.S.C. #102(b) under which its conclusion as to invalidity was reached.

Although the Eighth Circuit affirmed the District Judge it will be noted that the aforesaid assigned errors present the three basic elements of the only issue involved in the conflict of decisions, not only as adopted and reiterated by the various infringers, but also as restated in the Patentee's currently pending Petition for Rehearing (in No. 255 O. T. 1963) wherein it will be found (p. 6) that the question there presented in simple or condensed form is:

> "Is the invention of the Bros patent in suit described in the Bros pamphlet, which was distributed more than one year prior to the filing date of the application for the patent, so as to constitute a statutory bar to the validity of the patent under 35 U.S.C. 102(b)?"

Returning to the present case it will be found that notwithstanding the Eighth Circuit's decision (50a) of May 27, 1963, affirming invalidity, the Fifth Circuit, by its decision (22a) of July 3, 1963, remanded the Texas case for a partial new trial "to permit hearing and determination of this limited matter," namely, "the substantive legal significance" of the Bros brochure (43a-45a). On this sole

issue the District Judge, adopting much of the reasoning of Judge Nordbye, also held the patent invalid, by the decision of January 10, 1964,[5] but that decision was reversed on September 14, 1965, by the Fifth Circuit decision (1a) which gave rise to the present Petition for Writ of Certiorari.

Thus, it is quite apparent that the Fifth Circuit Court of Appeals not only recognized the precise nature and scope of the issue, which it anticipated the Supreme Court would review (3a), but also and even earlier highlighted the issue by making it clear (43a) that it is:

> "not, therefore, the more routine case in which validity or invalidity turns on intricate evidentiary questions of prior art, anticipation, lack of invention, novelty or the like."

For the same reasons it follows that a defense under Sec. 102(b) is similarly distinguishable from the cases[6] which the Supreme Court currently has under consideration in which patentability depends on degree of *inventiveness* over the *prior art* or *obviousness, at the time the invention was made,* all being considerations directly involved under Sec. 103, but not at all under Sec. 102(b).

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[5]*Bros Inc. v. W. E. Grace Mfg. Co. et al.*, 140 USPQ 324.

[6]*Graham v. John Deere Co., John Deere Co. v. Graham*, No. 11, O.T. 1965, *Calmar, Inc. v. Cook Chemical Co.*, No. 37, O.T. 1965, and *United States v. Adams*, No. 55, O.T. 1965.

ARGUMENTS

The petition fails to make out a case for review by certiorari

The Infringers' petition rests on the answers to two carefully worded academic questions (p. 3) neither of which presents an issue on which the Fifth and Eighth Circuits are in conflict. On this point reference is made to the following argument found on pages 8-9 of the respondents' brief opposing certiorari in the related Eighth Circuit case (No. 255 O. T. 1963).

> "Furthermore, it is clear that granting certiorari is not warranted just by reason of the fact that two different circuit courts have reached different results as to the validity of the same patent. See *Aeronautical Communications Equipment, Inc. v. Pierce*, 371 U.S. 954 (1963), denying certiorari. In that case, the Fifth Circuit had held Pat. Nos. 2,133,642 and 2,133,646 valid, and certiorari was denied, although the First Circuit had held Pat. No. 2,133,642 invalid on three occasions; the Third Circuit had held Patent No. 2,133,642 invalid; the First Circuit had held Pat. No. 2,133,646 invalid; the Petitioner sought certiorari on the grounds of conflict; and respondent admitted the conflict." (Footnote references here omitted.)

The Petitioners have not complied with the Rules of this Court, particularly subdivisions 1(c) and 4 of Rule 23, and not having accurately or clearly presented the issue in conflict, as herein brought out, this Court is under no obligation to revise, interpret or otherwise pass on the petition.[7]

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[7] *Namet v. United States*, 373 U.S. 179, 83 S.Ct. 1151.

The first question presented

After considering the documented background of facts as given in the foregoing Counterstatement, it should be evident that the main question as phrased by the Infringers (p. 3), as well as the Arguments that follow (pp. 10-13), evade or conceal rather than define and present the point of conflict.

Before the Fifth Circuit felt able to determine whether or not *the invention* of the Bros patent was disclosed in the Bros brochure, it first posed the logical elementary inquiry (9a):

> "What is the invention?—not merely as to the device, but what is it the law regards as *the invention*?"

It then notes the mandatory statutory requirement (35 U. S.C.A. § 112) for "claims—distinctly claiming the subject matter which applicant regards as his invention," further concluding that:

> "we, and all other courts have often held that it is the claim of a patent that measures the invention, etc."

and

> "This means every element of each patent claim is deemed to be material to the inventive concept."

The Court then proceeded to consider the disclosure of the brochure in great detail, to analyze the claims one by one, phrase by phrase, word by word, and to point out numerous positive and critical claim limitations that simply cannot be found in the pamphlet. Had the Eighth Circuit made the same intensive study and analysis it is doubtful

that there would ever have been any conflict between courts. Even the Sixth Circuit Court of Appeals, in its decision,[8] stated that:

> "Upon careful analysis, the claims of the patent in suit seem to present a distinctive inventive concept which had no equivalency in the prior art."

and it then made an extremely accurate resume of the claim language.

In spite of the foregoing, we now learn from the present petition (p. 11) that:

> "The Fifth Circuit made a shibboleth of the patent claims—and very literally so."

and to do so for:

> "time-bar purposes as the Fifth Circuit has done, is to grant claim language a mystical significance that has no warrant, etc."

The argument then continues with the still more amazing contentions (p. 12) that:

> "the invention and the grant are not necessarily the same"

that:

> "For time-bar purposes, it has always been the inventive substance and not the claim that governs."

and that the Fifth Circuit was *wrong* in its basic position:

> "that the claim limitation details must, as a matter of law, be taken to define the inventive substance."

---

[8]*Gibson-Stewart v. Bros*, 264 F.2d 776, at 780.

It is impossible to equate petitioners' position, as thus exposed, either with the query contained in its primary question (p. 3), or with basic tenets of patent law.

Another elementary rule of patent law (17a) carefully applied by the Fifth Circuit Court of Appeals, but virtually ignored in the present petition, as it was in the Eighth Circuit courts, is that "the Patent Office history is relevant if questions arise as to scope or interpretation of claims" (9a-10a), particularly where, as here, it is abundantly established that during the Patent Office prosecution the claims were imposed with limitations that described the very structural features and characteristics that are not disclosed in the brochure (13a). This being true the Court was:

> "left with the certain conviction that this patent (as it) comes to us—is not disclosed by the brochure which leaves so many elements of the claims unrevealed." (Authorities.)

and consequently the District Court was reversed because (17a):

> "this critical fact finding was not made in the light of the correct controlling legal principles." (Authorities.)

Here there is little if any real need to refer to the Patent Office proceedings because the claims are clear and distinct, and should need no "interpretation." The Patent Office record is important, however, because it established the specific fact that the claims were not allowed until they included the very limitations that distinguish them from the disclosure of the pamphlet. In spite of the criticalness of this fact petitioners characterize the distinctions as "in-

nocuous claim limitations" and refer to the Eighth Circuit decision (50a) as having "said that these limitations are of no consequence" (p. 13). We do not find where that decision so holds, or that it discusses any of the critical claim limitations at all. In any event, and if this is a point of decisional conflict between the Fifth and Eighth Circuits, it has not been put in issue as a question to be resolved in this case under the present petition.

The additional question collaterally presented

Petitioners' second question (p. 3) can only be construed as an attempt to elicit judicial sympathy by attacking the character of one of the Patentee's witnesses who had made an affidavit containing a statement that was subsequently found to be incorrect but which, when made, was conscientiously believed to be true, and was promptly corrected when the error was discovered. Under these circumstances this Court is being requested to sanction a right to counterclaim for damages by the Petitioners, and presumably without regard to whatever disposition is made of the issue raised by the first question presented.

This request should be summarily rejected and for a number of reasons, only a few of which need be stated, as follows:

When Judge Nordbye held, as he did by his decision (58a) of February 21, 1962, that the Bros pamphlet was distributed more than one year prior to the Bros application filing date, it was a finding of fact that the Patentee has never challenged since that date, even in the appeal that was taken to the Eighth Circuit Court of Appeals. Nor has the "time" of the publication ever been an issue in the Dallas or Fifth Circuit courts since before the 60(b)

hearing when the Patentee through extensive voluntary investigation was able to determine precisely what the publication date was. The only reason for taking testimony on the question at all was not to determine the date of the publication, but rather to clear the name and reputation of the witness from charges of fraud and concealment that he had been repeatedly subjected to by counsel for the Infringers. Patentee was more than grateful for the opportunity thus given, and the resulting effort fully vindicated the witness because the Fifth Circuit decision of September 14, 1965 (1a) concluded that it is "Expunging now the aspersions of purposeful misconduct" because "we do not think it (the Affidavit) shows a deliberate evil purpose to misstate or conceal or thereafter engage in foot-dragging lest the truth might be uncovered." (6a).

Another reason why the second question should not be considered is that if the conduct or sworn statements of the Patentee are to be investigated then surely the conduct and sworn statements of the Petitioners should also be examined,[9] and if that is done it will be found that Petitioners' conduct in this litigation alone has been far from exemplary. This was recognized by the Fifth Circuit in its decision[10] of July 3, 1963, when it said:

> "Except for the relative minor dispute concerning the time for commencement of damages, the Patentee sustained all of its contentions. Nothing the Patentee did either precipitated the necessity for the reference, nor did it prolong it. Indeed, as between the two the criticism on that score if any is made should more properly be directed at the Infringer whose inaccurate,

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[9]*Keystone Driller Co. v. General Excavator Co.*, 290 U.S. 240, 54 S.Ct. 146.

[10]*Bros Inc. v. W. E. Grace*, 320 F.2d 594, at 600.

inadequate, incomplete or nonproduced records brought about so much of the confusion."

Petitioners attempt finally (p. 14) to justify their charge of misconduct of Patentee, by reliance on three authorities, namely, (1) *Restatement Torts,* § 873; (2) *Shawkee Mfg. Co. v. Hartford-Empire Co.,* 322 U.S. 271; and (3) *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp.,* 86 S.Ct. 347.

The quotation from the *Restatement* is immediately ruled out because it requires *inter alia* that an incorrect or untrue statement be made "with knowledge of its falsity," a prerequisite that has not and cannot here be established against Patentee or its witness.

The *Shawkee* decision was one in which this Court recalled an earlier mandate and remanded the case for further proceedings because of direct and positive proof of a "fraudulent conspiracy" including "fraud" in obtaining the patent as well as "fraud" in obtaining a judgment. There is clearly no analogy with the present situation.

In the recent (Dec. 1965) *Walker Process* case the only question before the Court was "whether the maintenance and enforcement of a patent (undeniably) obtained by (intentional) fraud on the Patent Office may be the basis of an action under § 2 of the Sherman Act." The distinction is equally plain. Here there is not only no evidence at all of "fraud," in or out of the Patent Office, but not once has the issue been raised since the evidence was produced at the 60(b) hearing.

CONCLUSION

The Petition for Writ of Certiorari should be denied because it merely presents academic questions that do not define or bring up for consideration any real issues in conflict between the Fifth and Eighth Circuit Courts of Appeal.

Respectfully submitted,

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Attorney for Respondent

CERTIFICATE OF SERVICE

Four copies of the foregoing *Respondent's Brief in Opposition to Petition for Writ of Certiorari* have been served on petitioners by airmailing the same, postage prepaid, to petitioners' attorney, Mr. Channing L. Richards, 303 Attorneys Building, Charlotte, North Carolina, 28202, this 11 day of February 1966.

ANDREW E. CARLSEN.

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APPENDIX B-1

CONCLUSIONS OF LAW

1. The Court has jurisdiction of the subject matter involved herein and of the parties hereto under the Patent Laws of the United States.

2. The Bros pamphlet, Exhibit D-4, was a printed publication distributed by the defendant more than one year prior to the filing on November 17, 1949, of the application which issued into the Bros patent No. 2,610,557, on September 16, 1952, and as the invention of the patent was described in such pamphlet, said patent, with respect to each of the four claims therein, is invalid under the provisions of 35 U. S. Code § 102(b).

3. Defendant's Counterclaim is dismissed.

4. Plaintiffs are entitled to appropriate judgment.

5. A thirty day stay may be entered herein.

6. IT IS SO ORDERED.

An exception is reserved.

Dated this 20th day of March, 1962.

By the Court:

/s/ GUNNAR H. NORDBYE,
Judge.

APPENDIX B-2

IN THE UNITED STATES DISTRICT COURT

Northern District of Texas
Dallas Division

Civil Action No. 7608

Bros Incorporated,

Plaintiff,

vs.

W. E. Grace Manufacturing Company, and William E. Grace,

Defendants.

Motion by Defendants Under Rule 59

NOW COME the defendants in the above entitled cause and respectfully move this Court, in accordance with the provisions of Rule 59 of the Federal Rules of Civil Procedure, to alter or amend the Final Judgment entered herein on March 9, 1962, or, in the alternative, to open or suspend the same, with leave for application to the Court of Appeals to authorize reopening of the Interlocutory Judgment heretofore entered on February 17, 1958, for the purpose of granting a partial new trial devoted to the issue of statutory invalidity of the patent in suit by reason of prior description in a printed publication, contrary to the conditions prescribed by 35 U.S.C. 102(b).

This motion is presently brought because the patent here in suit has now been found invalid by a Memorandum De-

cision of Judge Gunnar H. Nordbye, dated February 21, 1962, in *Browning Mfg. Co. and Shovel Supply Co. v. Bros, Inc.*, Civil Action No. 4-59 Civ. 92, pending at Minneapolis in the United States District Court for the District of Minnesota. Judge Nordbye's finding of invalidity was based specifically and solely on the particular issue for which a partial new trial is sought by the present motion; namely, that the patent in suit is invalid for having been described in a prior printed publication, as appears from the certified copy of the aforesaid Memorandum Decision that is appended. * * *

The undersigned attorney for defendants hereby certifies that this motion is presented in good faith, that it is not interposed for purposes of delay, and that in his judgment it is well founded.

Respectfully,

/s/ CHANNING L. RICHARDS,
303 Attorneys Building,
Charlotte 2, North Carolina,
Attorney for Defendants.

APPENDIX B-3

IN THE UNITED STATES DISTRICT COURT

Northern District of Texas
Dallas Division

Civil Action No. 7608

Bros Incorporated, Plaintiff,

vs.

W. E. Grace Manufacturing Company, and William E. Grace, Defendants.

Defendants' Notice of Appeal

Notice is hereby given that defendants W. E. Grace Manufacturing Company and William E. Grace appeal to the United States Court of Appeals for the Fifth Circuit from the Order entered in the above entitled cause on April 17, 1962, denying the Motion by Defendants under Rule 59; and hereby petition the aforesaid Court of Appeals to suspend the Final Judgment entered herein on March 9, 1962, and to authorize reopening of the Interlocutory Judgment heretofore entered on February 17, 1958, for the purpose of granting a partial new trial devoted to the issue of statutory invalidity of the patent in suit by reason of prior description in a printed publication, contrary to the conditions prescribed by 35 U.S.C. 102(b).

/s/ CHANNING L. RICHARDS,
303 Attorneys Building,
Charlotte 2, North Carolina,
Attorney for Defendants.

APPENDIX B-4

IN THE UNITED STATES DISTRICT COURT

Northern District of Texas
Dallas Division

Civil Action No. 7608

Bros Incorporated,

Plaintiff,

vs.

W. E. Grace Manufacturing Company, and William E. Grace,

Defendants.

Statement of Points

The defendant-appellant, Bros Incorporated, makes the following statement of points on which it will rely on this appeal.

1. The District Court erred in its understanding of the subjects-matter of the claims of the patent in suit and in not construing those claims in the light of the Patent Office proceedings resulting in the allowance of such claims.

2. The Court erred in its substitute Finding of Fact No. 21 in holding that the inventive concept of the patent claims in suit is fully disclosed in the Bros pamphlet, Defendant's Exhibit D-4.

3. The Court erred in its interpretation of Section #102(b) of 35 U. S. Code and in its Conclusion of Law

#2 that each of the four claims of the patent in suit are invalid under the provisions of said Section.

CARLSEN, CARLSEN & STURM,
By /s/ ANDREW E. CARLSEN,
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Attorneys for Defendant.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1965

No. 915

W. E. GRACE MANUFACTURING COMPANY and
WILLIAM E. GRACE,
Petitioners,

vs.

BROS INCORPORATED,
Respondent.

PETITIONERS' REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1965

No. 915

W. E. GRACE MANUFACTURING COMPANY and
WILLIAM E. GRACE,
Petitioners,

vs.

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Respondent.

PETITIONERS' REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I. The Petition Here Is Submitted to State Exactly the Point of Conflict Between the Fifth and Eighth Circuits.

The burden of the respondent-patentee's brief in opposition is that petitioners have failed to define the issue of acknowledged conflict between the Fifth and Eighth Circuits.

There is nothing to this attack on the petition.

When invalidity of respondent's patent (R. 425) was affirmed in the Eighth Circuit (App. 50a) by reason of the printed publication "time-bar" at issue, the Minnesota Dis-

trict Court had recognized that the publication (R. 401) might be said to lack "exact drawings and specifications," and had consequently dealt specifically with extensive argument of the defendant-patentee (the respondent here) challenging the effectiveness of this publication (R. 401) as a "time-bar" because it did not "completely disclose all of the elements of the patent claims" (App. 58a, 66a). What the Minnesota District Court said in answer to such argument was this:

> ". . . . Defendant has listed some eleven features which it contends the pamphlet does not disclose. The list includes such items as the draft beam running the length of the machine, the bearing beams at the lower ends of the recess, the rocker beams support of the recess walls, etc. But all of the items referred to by defendant relate primarily to the bracing of the machine against the stresses to which it would be subjected while in actual operation. It seems apparent that any competent engineer in the industry with the drawings and photographs disclosed in this pamphlet would know the stresses and strains to which the machine would be subjected and would brace the machine accordingly. In other words, the bracing of the machine would be merely the application of ordinary mechanical skill. The essence of the invention, that is, the inventive concept which is the basis for the claims of this patent was fully disclosed by this pamphlet. The denial to an inventor of the fruits of his contribution to the art by reason of the publication of his own catalog more than one year prior to the application for a patent may seem harsh and unyielding, and an issued patent should not be lightly annulled. But the clear language of the statute permits no other finding in the light of the impelling evidence. . . . ." (App. 58a, 66a-67a).

The Eighth Circuit affirmed on the basis of its view that the Minnesota District Court had applied the correct test

for determining the adequacy of a printed publication as a "time-bar"; namely, whether the "knowledge" to be derived from the publication was "sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use" (App. 50a, 55a). As thus stated, the test originated in *Seymour* v. *Osborne*, 11 Wall. 516, 555 (1871), in a context that rang the same theme through several variations, one of which was twice referred to by the Fifth Circuit below (App. 1a, 8a-9a in relation to footnotes 7 and 8).

Evidently, then, the Fifth and Eighth Circuits both recurred to the same first principle. But this circumstance is no sooner noticed than the point of departure and ultimate conflict becomes equally clear, for it is beyond missing that the Fifth Circuit had to refine the first principle specially in order to reach its result below.

The Fifth Circuit refinement takes the form of generalizing an equation between the invention and the patent claim so as to adopt the view that "every element of each patent claim is deemed to be material to the inventive concept" (App. 1a, 9a), and in this way providing a basis for stating specially its test of printed publication "time-bar" adequacy as depending on "whether or not the brochure" (i.e., the publication, R. 401) "discloses structural features and characteristics that are precisely defined in the claims" (App. 1a, 13a).

In such terms, it is submitted to be exactly the question presented by this petition that the Fifth Circuit answered affirmatively in order to justify its reversal of the Texas District Court. Without this specially constructed justification the fact finding by the trial court would have been beyond proper reach just as it was in the Eighth Cir-

cuit, where the question that the petition presents was implicitly answered in the negative. And it is submitted to be exactly in such terms that conflict exists here between the Fifth and Eighth Circuits.

II. The Stated Point of Fifth and Eighth Circuit Conflict Is Submitted to Present a Question of Basic Importance to the Maintenance of a Reasonable Certainty in the Operation of the Patent Laws.

It begs the question to suggest, as the brief in opposition does (at p. 2), that the "vital point of substantive patent law" at issue (App. la, 3a) is simply a matter of whether the Fifth Circuit was right or wrong. Without more the Fifth Circuit result would not call for particular notice in either event.

The "vital point" of conflict that deserves definitive consideration by this Court is whether a Section 102(b) "time-bar" depends on identity with claim limitation detail in accordance with the Fifth Circuit view, or is governed by inventive substance as the Eighth Circuit has held.

It is true that, by way of preface, the Fifth Circuit appears to acknowledge that "the inquiry must be one of substance" and that "the statutory bar is hardly to be confined to the sterile precision of claim jargon" (App. la, 10a). But having thus referred to substance in passing, the Fifth Circuit dismissed all other evidence in favor of an "analysis," by respondent-patentee's expert witness, "demonstrating the limitations imposed during the Patent Office prosecution and the presence or absence of those in the brochure" (App. la. 11a-13a).

There is never a word by the Fifth Circuit to indicate any critical conclusion that the demonstrated claim limitations represent inventive substance. The Fifth Circuit conclusion is simply that the printed publication at issue

(R. 401) does not show precisely what some of the demonstrated limitations recite, and that those limitations not precisely shown must, as a matter of law, be viewed as material and controlling, without regard to their remaining significance in the face of the substantial printed publication showing (R. 401) of the very device that was subsequently patented (R. 425).

On virtually identical records both the Minnesota District Court (App. 58a, 68a) and the Texas District Court below (R. 388) found that there was no remaining significance in the claim limitation detail through which the Fifth Circuit labored (App. la, 13a-17a) to spell out a lack of precise identity with the printed publication (R. 401).

The Eighth Circuit affirmed (App. 50a, 55a) on the ground that it was for the trial court to determine from the evidence whether the printed publication (R. 401) had taught those skilled in the art the substance of what was subsequently patented (R. 425). The Fifth Circuit reversed (App. la, 16a-17a) on the ground that, because claim limitation detail should determine substance in its view, there was no warrant "for disregarding as utterly immaterial those specifically added limitations which were indispensable in securing the allowance of the patent" (App. la, 16a).

The resulting conflict of Fifth and Eighth Circuit views should not be allowed to stand, for there is no practical possibility of workable compromise on middle ground. It would be entirely unrealistic to suppose that a printed publication disclosure was more than rarely apt to appear in precise correspondence with the limitations of subsequently obtained patent claims. Yet printed publications form a principal means by which the skill of the art is continually informed, and from which the art should remain free to draw information and put it to practical use.

But how can such freedom be depended upon without knowing which of the conflicting Fifth and Eighth Circuit views will govern the treatment of subsequently appearing patent claims which pose, by mere appearance, a prima facie basis for restriction.

The Section 102(b) "time-bar" provisions ought not to be left in the uncertain state that is imposed by the present conflict.

III. The Conflict at Hand Is Submitted to Demonstrate That the Question Presented Can Be Resolved Only by This Court.

The brief in opposition concedes (at p. 1) that there is conflict here "on exactly the same basic and critical facts." Something should, therefore, be added concerning the curious result of this conflict over the rule of law that should be applied to the same facts.

The Fifth Circuit action against the defendant-petitioners originated in the Texas District Court at Dallas, where petitioners conduct their manufacturing operations. An additional infringement action by the respondent-patentee is pending in the District Court at San Antonio. *Bros Inc.* v. *Tampo Mfg. Co.*, Civil Action 2860 (W.D. Texas). Of the two, successful, declaratory judgment plaintiffs that were accused of infringement in the Eighth Circuit action (App. 50a), both are also competing manufacturers, and one (Browning) is located at San Antonio, while the other (Shovel Supply) operates at Dallas.

Curious is the least that may be said of the resulting situation. The four Texas manufacturers that have been accused of infringement are a major source for equipment of the patented sort, and they have made the field competitive (R. 147-150). The defendant-petitioners in particular have worried the respondent-patentee pricewise (R.

149). And this competitive activity began in Texas as a matter of course in response to bid invitations from the United States Corps of Engineers (R. 186-191), well before the respondent's patent (R. 425) issued, and when the only information at hand concerning the subsequently patented device was given by the respondent's printed publication (R. 410) at issue here (R. 56-57; R. 191).

Now, however, this competitive source faces the possibility of being cut in half by happenstance. Two of the manufacturers involved are free of respondent's patent (R. 425) because they forehandedly sought relief in the Eighth Circuit, while their respectively neighboring counterparts must deal with the same patent as if it were valid as a result of having waited for action in the Fifth Circuit.

The unevenness of this result can only be corrected by this Court, for the unevenness is representative mischief that will be repeated as long as a choice remains between the conflicting Fifth and Eighth Circuit views of the Section 102(b) "time-bar" provisions. The issue is an important one that has been disturbing Patent Office affairs too, as appears from the current petition in *Application of Foster*, No. 347, this Term, and it ought now to be resolved.

IV. The Collateral Question Was Additionally Presented, As It Was to the Courts Below, for Fear of Possible Waiver Through Omission, but the Question Is Also Submitted Here to Show the Court a Further Point That Is Believed of Special Significance to Orderly Operation of the Federal Rules, Even Though the Point Is Admittedly Collateral.

Because the brief in opposition (at p. 2) views the presented collateral question as "entirely irrelevant," petitioners feel it should be noticed that the Fifth Circuit (App. la, 4a-6a) does not suggest there was ever any rea-

sonable basis for the respondent-patentee's now discredited affidavit activity, and that a confirmation of the always apparent time of publication would not have had to wait over four years for the belated alarm of "the top owner-management of Patentee" (App. la, 5a) if there had been a responsible discovery response in the first place (R. 308-309); but the matter is admittedly collateral and it will not be pressed further here without permission.

Respectfully,

CHANNING L. RICHARDS
Attorney for Petitioners

CERTIFICATE OF SERVICE

Four copies of the foregoing Petitioners' Reply Brief in Support of Petition for Writ of Certiorari have been served on respondent by depositing the same in the United States mails, with first-class postage prepaid, addressed to respondent's attorney, Andrew E. Carlsen, Esq., at 1128 Plymouth Building, Minneapolis, Minnesota, this 23rd day of February, 1966.

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